(1) Supreme Court, U.S.
FILED

02 300 AUG 22 2002

OFFICE OF THE CLERK

No. 02-

IN THE

Supreme Court of the United States

EPPENDORF-NETHELER-HINZ GMBH,

Petitioner,

v.

RITTER GMBH AND
RK MANUFACTURING, INC.,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

PETITION FOR A WRIT OF CERTIORARI

CARTER G. PHILLIPS
JOSEPH V. JEST
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

PETER J. TOREN*
DAVID TOREN
SIDLEY AUSTIN BROWN & WOOD LLP
787 Seventh Avenue
New York, NY 10019
(212) 839-5300

Counsel for Petitioner

August 22, 2002

* Counsel of Record

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

60 pp

QUESTIONS PRESENTED

1. Whether this Court should resolve the circuit conflict as to the relevance in light of *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001), of the availability of alternative designs in determining whether a product's trade dress is "functional" or "non-functional."

2. Whether this Court's decision in *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001), changed the traditional test for determining "functionality" or "non-functionality" so as to limit Lanham Act protection to trade dress that is composed of only arbitrary, incidental, or ornamental features, thus precluding protection for trade dress that includes multiple individual elements some or all of which are *de facto* functional.

RULE 29.6 STATEMENT

The caption contains the names of all parties that appeared in the Fifth Circuit. Since the trial in this matter petitioner Eppendorf-Netheler-Hinz GmbH has changed its name to Eppendorf AG. Petitioner has no parent companies or publicly traded subsidiaries.

TABLE OF CONTENTS

	Page
QUESTIONS PRESENTED	i
RULE 29.6 STATEMENT	ii
TABLE OF AUTHORITIES	iv
OPINIONS BELOW	1
JURISDICTION	1
CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED	1
INTRODUCTION	2
STATEMENT OF THE CASE	5
REASONS FOR GRANTING THE PETITION	11
I. THE FIFTH CIRCUIT'S DETERMINATION THAT THE AVAILABILITY OF ALTERNATIVE DESIGNS IS IRRELEVANT TO DETERMINING NON-FUNCTIONALITY CONFLICTS WITH A DECISION BY THE FEDERAL CIRCUIT	11
II. THE FIFTH CIRCUIT'S DECISION IS IN CONFLICT WITH THIS COURT'S "FUNCTIONALITY" JURISPRUDENCE	16
III. THE CIRCUIT CONFLICT AT ISSUE HERE DIRECTLY IMPLICATES IMPORTANT NATIONAL ECONOMIC CONCERNS AND LEGISLATIVE GOALS AND THUS CALLS FOR A UNIFORM NATIONAL STANDARD	20
CONCLUSION	22

TABLE OF AUTHORITIES

CASES Page

Braxton v. *United States*, 500 U.S. 344 (1991)..... 11
Coach, Inc. v. *We Care Trading Co.*, No. 99 CIV.11672 (DLC), 2001 WL 812126 (S.D.N.Y. July 18, 2001)..... 19
Inwood Labs., Inc. v. *Ives Labs., Inc.*, 456 U.S. 844 (1982)..... 4, 5, 12, 21
Hartford House, Ltd. v. *Hallmark Cards, Inc.*, 846 F.2d 1268 (10th Cir. 1988)..... 18
In re Morton-Norwich Prods., Inc., 671 F.2d 1332 (C.C.P.A. 1982)..... 14, 17
Pebble Beach Co. v. *Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998)..... 17
Qualitex Co. v. *Jacobsen Prods. Co.*, 514 U.S. 159 (1995)..... *passim*
Sicilia Di. R. Biebow & Co. v. *Cox*, 732 F.2d 417 (5th Cir. 1984)..... 18, 19, 21
Sunbeam Prods., Inc. v. *West Bend Co.*, 123 F.3d 246 (5th Cir. 1997), *cert. denied*, 523 U.S. 1118 (1998)..... 20
Tools USA & Equip. Co. v. *Champ Frame Straightening Equip., Inc.*, 87 F.3d 654 (4th Cir. 1996)..... 18
TrafFix Devices, Inc. v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001)..... *passim*
Two Pesos, Inc. v. *Taco Cabana, Inc.*, 505 U.S. 763 (1992)..... *passim*
Valu Eng'g, Inc. v. *Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002)..... 2, 3, 11, 14, 15
Wal-Mart Stores, Inc. v. *Samara Bros., Inc.*, 529 U.S. 205 (2000)..... 11, 16

STATUTES

15 U.S.C. § 1125(a)..... 2
28 U.S.C. § 1295(a)(4)(B)..... 16

TABLE OF AUTHORITIES – continued

RULE Page

Sup. Ct. R. 10 ..... 2, 17

SCHOLARLY AUTHORITY

1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2002) 18

PETITION FOR A WRIT OF CERTIORARI

Petitioner Eppendorf-Netheler-Hinz GmbH ("Eppendorf") respectfully petitions this Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Fifth Circuit in this case.

OPINIONS BELOW

The opinion of the Fifth Circuit was entered on April 22, 2002, is reported at 289 F.3d 351, and is reproduced in the appendix hereto ("App.") at 1a-11a. The order denying petitioner's petition for rehearing en banc, App. 25a-26a, was entered on May 24, 2002, and is not reported. The final judgment of the United States District Court for the Southern District of Mississippi, App. 12a-16a, was entered on October 31, 2000, and is not reported.

JURISDICTION

The judgment of the Fifth Circuit was entered on April 22, 2002. A petition for rehearing en banc was denied on May 24, 2002. App. 25a-26a. The jurisdiction of the Fifth Circuit was based on 28 U.S.C. § 1291. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

Section 43(a) of the Lanham Act provides in part:

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which –

> (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . .
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

15 U.S.C. § 1125(a).

INTRODUCTION

In this case, all of the customary criteria for certiorari are readily met. See Sup. Ct. R. 10.

First, a split between the circuits exists concerning whether, after this Court's decision in *TrafFix Devices, Inc.* v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001), the availability of alternative designs may be considered in determining the "functionality" or "non-functionality" of product trade dress. The Fifth Circuit held below that after *TrafFix*, "alternative designs are not germane to the traditional test for functionality," App. 11a, while the Federal Circuit held earlier this year that evidence of the availability of alternative designs remains relevant after *TrafFix*. *Valu Eng'g, Inc.* v. *Rexnord Corp.*, 278 F.3d 1268, 1276 (Fed. Cir. 2002).

Under the "traditional" or *Inwood* test for determining whether a trade dress is legally functional or non-functional, a product design is "functional," in general terms, "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." *TrafFix*, 532 U.S. at 32 (internal quotation omitted) (quoting *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 850 n.10 (1982)). Applying this test in *TrafFix* – where the "functionality" of the trade dress, essentially only a single element or feature of the product design, was demonstrated as a matter of law by an

expired utility patent and its related prosecution and litigation enforcement history – this Court concluded that it was unnecessary on the facts there to consider the design alternatives that had been speculated upon by the Sixth Circuit. *Id.* at 33-34.

The instant case involves a product design trade dress concerning which Eppendorf never obtained (or sought) a utility patent, focused much of its product advertising and promotion upon the look and visual depiction of the Combitips brand design, and presented at trial (as found by the Fifth Circuit below) extensive evidence of available alternative designs. See App. 9a. Nonetheless, the Fifth Circuit reversed a jury verdict and resulting judgment entered for Eppendorf following a two-week trial, holding that under *TrafFix* "alternative designs are not germane to the traditional test for functionality." *Id.* at 11a.

In contrast, reasoning that *TrafFix* did not change the test for determining "functionality," the Federal Circuit held earlier this year that evidence of the availability of alternative designs remains relevant to a determination of whether a particular design is a protected trade dress which cannot be copied by competitors. *Valu Eng'g*, 278 F.3d at 1276 (discussing *TrafFix*).

Second, the Fifth Circuit's opinion conflicts with decisions of this Court. In *TrafFix*, this Court forcefully re-affirmed the traditional or *Inwood* standard. 532 U.S. at 32-33. Misconstruing *TrafFix*, the Fifth Circuit rejected its own well-developed functionality jurisprudence, previously cited with approval by this Court, compare App. 6a-7a, with *Two Pesos, Inc.* v. *Taco Cabana, Inc.*, 505 U.S. 763, 775 (1992) (citing *Sicilia Di. R. Biebow & Co.* v. *Cox*, 732 F.2d 417 (5th Cir. 1984)), and held below that a trade dress feature is protectable only if it is "incidental, arbitrary or ornamental" or an "arbitrary flourish which serve[s] no purpose." See App. 5a, 10a. In doing so, the Fifth Circuit erroneously relied upon inapposite language from *TrafFix* concerning an example

provided by this Court as to how a trade dress plaintiff might seek to overcome the heavy evidentiary burden it would face "[w]here the expired [utility] patent claimed the features in question." 532 U.S. at 30. Thus, the Fifth Circuit has reversed the analysis applicable under the traditional test. *TrafFix* found that the disclosure of the claimed trade dress in an expired utility patent constituted strong evidence of functionality and then asked whether the plaintiff could overcome that evidence, "for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device." In contrast, the Fifth Circuit has effectively created a new, threshold "incidental, arbitrary or ornamental" test that its own extensive precedent had not found under the *Inwood* test and that was neither considered nor announced in *TrafFix*.

Third, the conflict between the Fifth and Federal Circuits concerns an economic matter of national importance. This Court has recognized that the primary purposes of the Lanham Act, including its protection of trade dress, are to "'secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.'" *Two Pesos*, 505 U.S. at 774 (quoting *Park 'N Fly, Inc.* v. *Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)); see *Inwood Labs., Inc.* v. *Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982) (to same effect). Moreover, as this Court also has observed, Congress has concluded that "'[n]ational protection of trademarks is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of a good reputation.'" *Two Pesos*, 505 U.S. at 774 (quoting *Park 'N Fly*, 469 U.S. at 198); see *TrafFix*, 532 U.S. at 28 (protection of "non-functional" trade dress promotes competition); *Qualitex Co.* v. *Jacobsen Prods. Co.*, 514 U.S. 159, 163-64 (1995) (economic objectives of trademark law are to reduce consumer costs of shopping and making purchasing decisions and to encourage the production of quality products).

The Fifth Circuit's decision threatens these important Congressional goals by severely limiting, and perhaps even effectively eliminating, the protection of design trade dress. It would lead improperly to the loss of the consumer goodwill developed by trade dress owners through substantial investments of their "energy, time, and money," *Inwood*, 456 U.S. at 854 n.14, and discourage investments in product quality and maintenance, thus denying consumers the recognized pro-competitive benefits served by the Lanham Act's protection of distinctive trade dress. The decision also generates confusion among consumers who can no longer rely upon a particular trade dress to denote the trusted source of the product in question, further undermining important national legislative goals. *Qualitex*, 514 U.S. at 163-64.

The Court should grant the petition, resolve the conflict between the circuits, and restore uniformity to this economically important area of federal law.

STATEMENT OF THE CASE

Eppendorf is a life sciences company headquartered in Hamburg, Germany. After a design and development period of approximately three years, Eppendorf began selling a line or family of dispenser syringes under the brand name Combitips, entering the U.S. market in 1980. At the time, and for a number of years thereafter, there were no dispenser syringes on the market that looked like the Combitips brand. See Trial Tr. ("T") 270/1-13, 308/23-309/4; see T.255/18-21.

Dispenser syringes fit into a device called a pipette dispenser, which is used in clinical, academic, pharmaceutical and other laboratories to dispense liquid aliquots for testing and analysis. The Combitips brand dispenser syringes became a quick success, backed by extensive advertising and promotion that focused on their appearance. T.269/4-18; T.254/1-255/24. By 1985 more than five million Combitips brand syringes were being sold in the United States per year, and by 1989 more than ten million per year. T.285/3-8;

T.284/22-285/2. Over the 20 years leading up to the trial in this action, Eppendorf sold nearly 145 million Combitips brand dispenser syringes in the United States at a total price of approximately 95 to 100 million dollars.

The trade dress of the Combitips – its overall look or appearance – is distinctive to users of dispenser syringes. As the jury found in its verdict by special interrogatories, Eppendorf developed secondary meaning and associated good will in that trade dress, as to each size of Combitips brand syringes and as to the Combitips taken together as a trade dress family. App. 13a.

Nearly 15 years after Eppendorf introduced the Combitips brand syringes into the United States, Respondent Ritter GmbH ("Ritter" or "defendant Ritter") began making dispenser syringes and in conjunction with Respondent RK Manufacturing, Inc. ("RK" or "defendant RK") (collectively, "defendants"), selling dispenser syringes in the United States.[1] Rather than developing a trade dress of its own, defendant Ritter copied virtually every detail of the Combitips design, *including* copying a design flaw. T.373/20-374/16; T.411/22-412/17.

Ritter not only slavishly copied the look of the Combitips brand syringes, but did so as to each size of the Combitips. See App. 14a, 18a-19a, 21a; Plaintiff's Trial Exhibits ("Pl. Exhs.") 1-2, 4G, 5A-M.[2] Defendants then furthered their infringing conduct by touting their product as being a "direct replacement" for the Combitips brand syringes. App. 21a-22a; T.307/5-24.

At the time that defendant Ritter was, unknown to Eppendorf, copying the Combitips design, Eppendorf had

---

[1] The founder, co-owner, and president of Defendant Ritter owned 50 percent of defendant RK and served as a director and president of RK, while other Ritter co-owners also served as RK officers and directors.

[2] Eppendorf makes eight sizes of the Combitips design dispenser syringes, ranging from .05 ml to 50 ml.

already begun developing a new line of dispenser syringes to be sold under the name Combitips Plus. The Combitips Plus brand syringes have a very different trade dress appearance, but function with the same type of pipette dispenser as the Combitips (as well as another type of pipette dispenser) and cost 15 percent *less* than the Combitips. T.1263/13-17; T.357/15-17, 1360/20-1361/4; T.1180/6-1181/7.[3]

The case was filed in June 1998 in the United States District Court for the Eastern District of New York. Following a transfer of venue to the Southern District of Mississippi and subsequent jury demand by defendant Ritter, the case was tried before a jury in June 2000.

No patents were at issue at trial. Eppendorf presented evidence of the extensive efforts that led to the development of secondary meaning in its Combitips design trade dress, including more than three million dollars in advertising and additional promotional efforts. T.254/1-272/13, 280/15-281/25, 284/3-290/10, 291/24-306/18. Eppendorf also presented extensive evidence demonstrating the availability of alternative designs that could use the same type of components as the Combitips design, but have a different appearance and would not affect use or purpose or (adversely) affect cost or quality. Indeed, Eppendorf proved not only the existence of different-looking overall designs, but also that the appearance of each of the eight individual elements of the overall Combitips design could be varied without affecting use or purpose or (adversely) affecting cost or quality.[4] The

---

[3] Reproduced at App. 27a-30a are Pl. Exs. 5A, 5C, 5G, and 5I, which are photographs of defendants' dispenser syringes and Eppendorf's Combitips and Combitips Plus brand dispenser syringes in, respectively, the .5 ml, 1.25 ml (1 ml in the compatible Combitips Plus line), 5 ml, and 12.5 ml sizes (10 ml in the Combitips Plus line). Reproduced at App. 31a is Pl. Ex. 4E, which is a photograph of a line of dispenser syringes made by a company named Oxford.

[4] The record shows that the appearance of the "rings" on the head or top of the plunger, the "fins" under the flange, the design of the plunger, the

record also shows that given the number of individual elements and the number of alternatives available under each element, a great number of overall design alternatives exist. T.458/6-19.

During the two-week trial, defendants sought to deny that they had copied the Combitips design, even when confronted with one of their own documents, a photograph of the Combitips, that had been doctored to white out the name "eppendorf." See App. 19a-20a. Neither the jury nor the experienced trial judge believed defendants' incredible efforts to deny deliberately copying the Combitips design. *Id.* at 14a-15a, 18a-22a.[5]

Defendants did admit at trial that they could have developed alternative designs and that competing alternative designs, different in appearance, were on the market.

---

design of the syringe tip, the volume of the syringes, the design of the flange, and the angle of the stump could each be altered in various respects, by, for example, changing their number, shape, size, form and/or length. T.365/19-366/3, 404/1-10, 439/16-440/1; T.362/13-19, 449/10-450/18, 1250/16-1251/17; T.366/4-368/25, 440/2-9; T.371/4-19, 447/10-19; T.372/9-373/9, 447/15-448/19; T.375/16-376/1, 453/17-22; T.376/25-377/9, 454/23-455/20, 1255/4-19. The color scheme of the Combitips brand syringes, which are made of plastic, also could be changed both as to the plastic used in the syringes and the printing on the syringes. T.377/21-378/5, 457/15-25. Various colors are commonly used and available in the industry, App. 31a; Pls. Exs. 7, 10, and 95; T.1478/1-1479/21, 1483/9-1485/9, and defendants themselves use green for their "medical products" line. T.987/15-18; *see* T.618/15-25. The color blue is used in conjunction with the Combitips Plus. App. 27a-30a; Pl. Exs. 4G and 7. All of these changes could be made to the Combitips design trade dress without affecting functionality, that is, without affecting use, purpose, cost or quality.

[5] By the time of their post-trial briefing, defendants finally abandoned their efforts to recast their false and evasive trial testimony, conceding that "[t]here is no dispute that [defendant] Ritter GmbH intended to make a product of the same design as Eppendorf's." R. at 1621 (Defs.' Opp'n to Pl.'s Mot. for Enhanced Damages, Prejudgment Interest, and Attorneys' Fees, at 15 (Aug. 7, 2000)).

T.601/22-603/12, 1081/15-1082/9, 1455/19-1456/25; see also T.1454/24-1455/18. They also admitted that a number of changes could be made to the Combitips design, both overall and as to individual elements, without affecting function or cost, T.1264/24–1265/2; T.1028/10-12, and that "artistic deviations" exist between dispenser syringe designs. T.1262/6-7, 1262/10-25.

The eight-member jury unanimously concluded that defendants Ritter and RK had infringed Eppendorf's trade dress rights in its family of Combitips brand dispenser syringes under Section 43(a) of the Lanham Act. The jury found that defendants had infringed the distinctive overall look or appearance of the Combitips design. The jury also found that defendants had acted willfully and with the intent to confuse or deceive or to appropriate the goodwill in Eppendorf's trade dress, and that Eppendorf had suffered damages in the form of lost profits of $750,000 and lost licensing fees of $250,000. App. 12a-15a.

After denying defendants' voluminous post-trial motions, the district court granted Eppendorf's post-trial motion for enhanced damages by an opinion and order dated October 31, 2000. The district court awarded $750,000 in enhanced damages and found, inter alia, that defendants had purposefully infringed Eppendorf's trade dress with the intent of stealing Eppendorf's customers and reducing Eppendorf's sales and profits. App. 17a-22a. However, the district court denied Eppendorf's motion for prejudgment interest and attorneys' fees. *Id.* at 22a-24a.

The district court also entered final judgment on October 31, 2000. App. 12a. Defendants appealed, and Eppendorf cross-appealed as to the denial of prejudgment interest and attorneys' fees. Following oral argument, the Fifth Circuit reversed, vacated the final judgment, and, without remand, entered judgment for defendants solely on the issue of "functionality." *Id.* at 11a.

The Fifth Circuit did not discuss the absence of any utility patent evidence or Eppendorf's advertising and promotional focus on the look or appearance of the Combitips. Focusing on the individual elements of the design rather than the design as a whole, the Fifth Circuit did acknowledge that "there is extensive testimony in the record regarding available alternative designs for each of the eight elements" used in the Combitips design. However, it held that after *TrafFix*, "alternative designs are not germane to the traditional test for functionality." App. 11a. Furthermore, without considering the question presented or analyzing the patent-related and product-specific evidence that was determinative in *TrafFix*, the Fifth Circuit also held that "only incidental, arbitrary or ornamental product features" can be part of protected trade dress. *Id.* at 5a.

Operating under these premises, the Fifth Circuit found that Eppendorf had not shown that the elements included in the Combitips design are "arbitrary flourish[es] which serve no purpose in the Combitips" and that Eppendorf had failed to prove (even as to color) that the "Combitip design elements are unnecessary, non-essential elements" of the Combitips trade dress. App. 10a. In the Fifth Circuit's view, even if "the appearance or number of [a particular design element] could be changed without affecting the function," that element nonetheless is "functional" so long as that element in some "shape, size or number" is needed for the operation of the product. *Id.* Thus, in reversing and entering judgment for defendants, the Fifth Circuit effectively equated *de facto* function with *de jure* "functionality" and ignored the evidence that available alternative designs employing the same design elements – but changed in appearance by varying them as to size, shape, number, angle and/or color – could be used without affecting use or purpose or (adversely) affecting cost or quality.[6]

---

[6] The Fifth Circuit stated in a footnote with regard to the design element referred to as the "fins" that "Eppendorf's experts also concede[d] that

REASONS FOR GRANTING THE PETITION

I. THE FIFTH CIRCUIT'S DETERMINATION THAT THE AVAILABILITY OF ALTERNATIVE DESIGNS IS IRRELEVANT TO DETERMINING NON-FUNCTIONALITY CONFLICTS WITH A DECISION BY THE FEDERAL CIRCUIT.

1. This Court has stated that a "principal purpose for which we use our certiorari jurisdiction . . . is to resolve conflicts among the United States courts of appeals." *Braxton* v. *United States*, 500 U.S. 344, 347 (1991). Here, the Fifth Circuit's determination that the availability of alternative designs is irrelevant after *TrafFix* in determining whether trade dress is "functional" or "non-functional" conflicts with the Federal Circuit's decision in *Valu Engineering, Inc.* v. *Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002). This conflict should be resolved by this Court.

2. "The trade dress of a product is essentially its total image and overall appearance." *Two Pesos*, 505 U.S. at 764 n.1 (internal quotation omitted). Trade dress thus includes the design of a product, see *TrafFix*, 532 U.S. at 28; *Wal-Mart Stores, Inc.* v. *Samara Brothers, Inc.*, 529 U.S. 205, 209-10 (2000), and "may include features such as size, shape, color

---

some of the suggested alternatives would slightly increase the cost of the product." App. 10a n.5. The Fifth Circuit did not specifically identify the testimony in question and, moreover, failed to address the record evidence indicating that the amount of plastic used per syringe for the fins is so small that any asserted difference would not play a role. T.395/12-25. The overall material costs for even one of the larger sizes of the Combitips brand dispenser syringes is less than 1 cent, T.369/7-15, with the fins accounting for a small fraction thereof. Thus, any change, if even measurable, would involve only thousandths or hundredths of that amount. T.395/12-25. Indeed, defendants conceded at trial that the per syringe cost of material was "not relevant." T.1028/10-12. Of course, even ignoring this evidence, alternatives are available that use fewer fins (and thus, to the extent measurable, less plastic for the fins), *see* T.362/14-19, 454/3-14, and alternatives exist as to each of the other elements, which can be combined to create numerous trade dress alternatives.

or color combinations, texture, graphics, or even particular sales techniques." *Two Pesos*, 505 U.S. at 764 n.1 (internal quotation omitted); see *Qualitex Co.* v. *Jacobsen Prod. Co.*, 514 U.S. 159 (1995) (color of product eligible for registration and protection as a mark).

"It is well established that trade dress can be protected under federal law." *TrafFix*, 532 U.S. at 28.

> The design or packaging of a product may acquire distinctiveness which serves to identify the product with its manufacturer or source; and a design or package which acquires this secondary meaning, assuming other requisites are met, is a trade dress which may not be used in a manner likely to cause confusion as to the origin, sponsorship, or approval of the goods.

Id.; see *Inwood*, 456 U.S. at 863 & n.5 (White, J., concurring in the result) ("The use of a product or package design that is so similar to that of another producer that it is likely to confuse purchasers as to the product's source may constitute 'false designation of origin' within the meaning of the [Lanham] Act.") (citing courts of appeals decisions).

Design trade dress that has acquired secondary meaning is protected from infringement by the Lanham Act if it is "non-functional," and this statutory protection of such non-functional trade dress "exists to promote competition." *TrafFix*, 532 U.S. at 28.

3. In *Inwood*, this Court stated that "[i]n general terms, a product feature is functional if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." 456 U.S. at 850 n.10. The Court reaffirmed and applied this "traditional" or *Inwood* rule in *TrafFix*, in reviewing a Sixth Circuit decision that reversed a grant of summary judgment for the defendant on a product trade dress claim. See 532 U.S. at 32-33.

The Court granted certiorari in *TrafFix* to resolve a conflict in the circuits on the issue of "whether the existence of an expired utility patent forecloses the possibility of the patentee's claiming trade dress protection in the product's design." *Id.* at 28. On the facts in *TrafFix*, the Court held that as a matter of law the plaintiff there could not establish "non-functionality" under the traditional or *Inwood* formulation.

The *TrafFix* plaintiff sought trade dress protection for a dual-spring design for a temporary road sign. The Court examined the expired utility patents that had been owned by the plaintiff and which claimed as their "central advance" the use of two springs. Indeed, a road sign stand with only one spring could not function like a road sign stand using the dual-spring design because it would topple over in heavy wind conditions. At the same time, the dual-spring design also was the "essential feature" of the plaintiff's alleged trade dress and the plaintiff "in essence [sought] protection for the dual-spring design alone." *Id.* at 30, 34.

The Court also examined the prosecution and litigation enforcement history relating to the expired utility patents. The prosecution history confirmed that the dual-spring sign allows outdoor sign stands to resist toppling in strong winds, while single-spring designs lack this important operational advantage, and a three-spring design would be unnecessary and simply increase costs. As to the enforcement of those expired utility patents, the plaintiff previously had obtained a ruling of patent infringement against another company for using a two-spring design that looked very different. Thus, the *TrafFix* plaintiff's own conduct established that the patent claims covered a design with two springs, even if that spring design looked very different. *Id.* at 30-31.

Based on this record, the *TrafFix* plaintiff could not overcome the "strong evidentiary inference of functionality based on the disclosure of the dual-spring design in the claims of the expired patents." *Id.* at 30. The Court thus held that

the "functionality" of the trade dress had been conclusively established on the facts there and that there accordingly was "no need, furthermore, to engage, as did the Court of Appeals [for the Sixth Circuit], in speculation about other design possibilities, such as using three or four springs . . . . Other designs need not be attempted." *Id.* at 33-34.

4. The Fifth Circuit construed the *TrafFix* decision to mean that "alternative designs are not germane to the traditional test for functionality." App. 11a.

Contrary to the Fifth Circuit's decision below, the Federal Circuit has specifically rejected the position that the availability of alternative designs is irrelevant after *TrafFix* in determining whether or not trade dress is "functional."

> We do not understand the Supreme Court's decision in *TrafFix* to have altered the *Morton-Norwich* analysis [concerning the evidentiary factors generally considered under Federal Circuit precedent in determining "functionality" or "non-functionality"].[7] As noted above, the *Morton-Norwich* factors aid in the determination of whether a particular feature is functional, and the third factor focuses on the availability of "other alternatives." *Morton-Norwich*, 671 F.2d at 1341. We did not in the past under the third factor require that the opposing party establish that there was a "competitive necessity" for the product feature. Nothing in *TrafFix* suggests that consideration of alternative designs is not properly part of the overall

---

[7] *See In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332 (C.C.P.A. 1982) (opinion for the court by Rich, J.). The *Morton-Norwich* factors are (1) the existence of a utility patent that discloses the utilitarian advantages of the design; (2) advertising materials in which the originator of the design touts the design's utilitarian advantages; (3) the availability to competitors of functionally equivalent designs; and (4) facts indicating that the design results in a comparatively simple or cheap method of manufacturing the product. *Valu Eng'g*, 278 F.3d at 1274 (citing *Morton-Norwich*, 671 F.2d at 1340-41).

> mix, and we do not read the Court's observations in *TrafFix* as rendering the availability of alternative designs irrelevant. Rather, we conclude that the Court merely noted that once a product feature is found functional based on other considerations there is no need to consider the availability of alternative designs, because the feature cannot be given trade dress protection merely because there are alternative designs available. But that does not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine whether a feature is functional in the first place. We find it significant that neither party argues that *TrafFix* changed the law of functionality . . . .

Valu Eng'g, 278 F.3d at 1276 (footnote added; original footnote omitted). The Federal Circuit then went on to quote Professor McCarthy, the leading trademark law commentator, who also has reached the same conclusion:

> "In the author's view, the observations by the Supreme Court in *TrafFix* do not mean that the availability of alternative designs cannot be a legitimate source of evidence to determine in the first instance if a particular feature is in fact 'functional.' Rather, the Court merely said that once a design is found to be functional, it cannot be given trade dress status merely because there are alternative designs available."

Id. (quoting 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7.75, at 7-180-1 (4th ed. 2001)).

5. The contrary positions adopted by the Fifth and Federal Circuits create a direct conflict that this Court should address now in order to provide much needed guidance to the courts of appeals. This conflict involves the "functionality" doctrine, which this Court has characterized as being "'important,'" *Qualitex*, 514 U.S. at 165, and which relates to product trade dress, an area of doctrinal difficulty and

frequent conflict among the circuits, as evidenced by this Court's grants of certiorari most recently in *TrafFix* and in *Wal-Mart Stores, Inc.* v. *Samara Brothers, Inc.*, 529 U.S. 205 (2000).

It is a conflict, furthermore, that effectively exceeds the jurisdictional bounds of the Fifth and Federal Circuits. As occurred in *Valu Engineering*, the Federal Circuit reviews decisions by the Trademark Trial and Appeal Board concerning applications to federally register trade dresses (and other types of marks). See 28 U.S.C. § 1295(a)(4)(B). Thus, if this conflict is not addressed, applications for trade dress registrations – which, if granted, are designed to provide the registration owner with nationwide rights to the mark in question – will be judged by the U.S. Patent and Trademark Office according to a standard contrary to the standard that would be applied to trade dress infringement claims adjudicated in the Fifth Circuit. See *Wal-Mart*, 529 U.S. at 210 ("'[T]he general principles qualifying a mark for registration under § 2 of the Lanham Act are for the most part applicable in determining whether an unregistered mark is entitled to protection under § 43(a).'") (quoting *Two Pesos*, 505 U.S. at 768). Moreover, the nationwide scope of rights granted by virtue of federal registration matches the practices of many businesses, including Eppendorf, whose products are sold across the nation.

Finally, the conflict is outcome determinative here, as the Fifth Circuit reversed the jury's verdict and the district court's final judgment based solely upon the issue of "functionality."

For all of these reasons, guidance clearly is needed from this Court.

II. THE FIFTH CIRCUIT'S DECISION IS IN CONFLICT WITH THIS COURT'S "FUNCTIONALITY" JURISPRUDENCE.

1. Misconstruing *TrafFix*, the Fifth Circuit panel effectively created a new, threshold test that would extend

Lanham Act protection only to trade dress that is merely "incidental, arbitrary or ornamental." App. 5a. Such a test is inconsistent with the traditional test as first articulated in *Inwood* and re-affirmed in *TrafFix*, a conflict that further heightens the need for review by this Court. See Sup. Ct. R. 10(c). The Fifth Circuit decision converts inapposite language from *TrafFix* into a test that few, if any, product designs could meet. It thus calls into question the continued viability of trade dress protection that Congress has confirmed in the Lanham Act and that this Court has recognized as promoting competition and the Act's underlying purposes. *TrafFix*, 532 U.S. at 28-29.

2. All products have a function or purpose and thus are *de facto* functional, that is, functional in the layperson's sense of the word.[8] Moreover, it has long been recognized that product trade dress is almost always composed of a combination of features that includes elements that at least serve a *de facto* function or purpose. *Morton-Norwich*, 671 F.2d at 1338 ("Most designs, however, result in the production of articles, containers, or features thereof which are indeed utilitarian, and examination into the possibility of trademark protection is not the mere existence of utility, but to the degree of design utility."); *accord Two Pesos*, 505 U.S. at 764 n.1 (trade dress may include features such as size, shape, color or color combinations, texture, and graphics).

Furthermore, it also is well recognized that where the trade dress includes multiple individual elements, the "functionality" inquiry does not turn on a determination as to the individual elements, but on whether the collection or combination of design choices taken together is "functional" or "non-functional." *Pebble Beach Co.* v. *Tour 18 I Ltd.*, 155

---

[8] Indeed, in a strict sense, every design feature, even those that are purely ornamental, can affect or contribute to the use or cost of a product (unless there is no measurable cost involved). *See, e.g., Morton-Norwich*, 671 F.2d at 1340 ("every design 'affects' or 'contributes' to the utility of the article in which it is embodied").

F.3d 526, 538 (5th Cir. 1998) (collection of functional features may be protectable depending upon whether the design as a whole is non-functional) (citing, inter alia, *Vaughn Mfg. Co.* v. *Brikam Int'l, Inc.*, 814 F.2d 346, 350 (7th Cir. 1987)); *Tools USA & Equip. Co.* v. *Champ Frame Straightening Equip., Inc.*, 87 F.3d 654, 658 (4th Cir. 1996) ("the critical functionality inquiry is not whether each individual component of the trade dress is functional, but rather whether the trade dress *as a whole* is functional") (citing cases from various circuits); *Hartford House, Ltd.* v. *Hallmark Cards, Inc.*, 846 F.2d 1268, 1272 (10th Cir. 1988) ("'virtually every product is a combination of functional and non-functional features and a rule denying protection to any combination of features including a functional one would emasculate the law of trade dress infringement'"); *Sicilia Di. R. Biebow & Co.* v. *Cox*, 732 F.2d 417, 425, 429 (5th Cir. 1984) (a design can contribute or be related to product function or utility and be non-functional and protected) (citing, inter alia, *Dallas Cowboys Cheerleaders, Inc.* v. *Pussycat Cinema, Ltd.*, 604 F.2d 200, 203-04 (2d Cir. 1979)).[9]

3. As discussed *supra* at 13, this Court granted certiorari in *TrafFix* to resolve a conflict as to whether a trade dress infringement claim is foreclosed by a utility patent that also claims the design in question. 532 U.S. at 28. In other words, the question presented in *TrafFix* was not whether the trade dress involved had a *de facto* function, but whether the existence of an expired utility patent conclusively established *de jure* "functionality."[10]

---

[9] 1 J Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7.76, at 7-187 & nn.2-3 (4th ed. 2002) ("Almost all courts adhere to this view. There is little dissent from this position.") (footnote omitted; citing numerous cases).

[10] As also discussed *supra* at 13, *TrafFix* involved essentially a single-element trade dress.

Addressing this question, this Court held that:

> Where the expired [utility] patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, *for instance* by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

Id. at 30 (emphasis added).

Thus, this Court's reference to a "merely . . . ornamental, incidental, or arbitrary aspect of [a] device" was made by way of example as to how a plaintiff might establish "non-functionality" where, unlike in this case, a utility patent claims the trade dress in question. The Court did not consider or announce a new rule that only such aspects of a device are potentially eligible for protection as part of a design trade dress, or require such a threshold showing by trade dress plaintiffs. The Court also did not hold that a trade dress, or even an individual feature of a multi-element trade dress (which was not at issue in *TrafFix*), is "essential" to use or purpose and thus "functional" unless it is, in the words of the Fifth Circuit below, an "arbitrary flourish which serve[s] no purpose." App. 10a.[11] Nor did the Court otherwise equate *de facto* function with *de jure* "functionality." Indeed, had it intended to do so, the Court simply could have noted that springs of some number are needed for such sign stands to

---

[11] To the extent that the Fifth Circuit's decision can be read as holding that trade dress cannot be protected where some or all of its individual elements are "functional," it would conflict with the established law of a number of various circuits. See discussion of cases *supra* at 17-18; *see also Coach, Inc.* v. *We Care Trading Co.*, No. 99 CIV.11672 (DLC), 2001 WL 812126, at *8 (S.D.N.Y. July 18, 2001) ("We Care's reading of *TrafFix* is incorrect. The *TrafFix* decision does not overrule Second Circuit law that a collection of functional features may nonetheless be protectable trade dress.").

function and thus would have held that the dual-spring design at issue there was, without more, "functional."

The Fifth Circuit's decision below reverses the analysis applicable under the *Inwood* test and applied in *TrafFix*, by requiring as a threshold matter a showing that a design or design feature, in order to be a protected trade dress, is merely "arbitrary," "incidental," or "ornamental."[12] Accordingly, petitioner submits that the Fifth Circuit's decision below conflicts with this Court's "functionality" jurisprudence, and that review of the Fifth Circuit's decision is appropriate and necessary.

III. THE CIRCUIT CONFLICT AT ISSUE HERE DIRECTLY IMPLICATES IMPORTANT NATIONAL ECONOMIC CONCERNS AND LEGISLATIVE GOALS AND THUS CALLS FOR A UNIFORM NATIONAL STANDARD.

The circuit conflict at issue here concerns – and in the case of the Fifth Circuit's decision undermines – the Lanham Act's protection of product trade dress. That statutory protection is designed, as this Court has consistently recognized, to promote important national economic interests and legislative goals. Trade dress protection provides both competitive and consumer benefits. It "'foster[s] competition and the

---

[12] In doing so, moreover, the Fifth Circuit decision below would jettison the functionality jurisprudence that the Fifth Circuit had developed and applied over a period of 20 years. Under its "utilitarian" approach to functionality, the Fifth Circuit would consider – consistent with the traditional or *Inwood* formulation's focus on use, purpose, cost or quality – factors such as whether the design was "superior or optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function or performance," or, if not, whether the design was "one of a limited number of equally efficient options." *See, e.g., Sicilia Di R. Biebow*, 732 F.2d at 429. This Court favorably cited the Fifth Circuit's "utilitarian" approach in *Two Pesos*. *See* 505 U.S. at 775 (citing *Sicilia Di R. Biebow*); *see also Sunbeam Prods., Inc.* v. *West Bend Co.*, 123 F.3d 246, 255-56 (5th Cir. 1997) (discussing same and quoting the *Inwood* formulation), *cert. denied*, 523 U.S. 1118 (1998).

maintenance of quality by securing to the producer the benefits of a good reputation.'" *Two Pesos*, 505 U.S. at 774; see *Qualitex*, 514 U.S. at 164 (Lanham Act "thereby encourage[s] the production of quality products") (alteration in original; internal quotation omitted). At the same time, it "'protect[s] the ability of consumers to distinguish among competing producers.'" *Two Pesos*, 505 U.S. at 774; see *Inwood*, 456 U.S. at 854 n.14 ("the infringer deprives consumers of their ability to distinguish among the goods of competing manufacturers"). Thus, it reduces consumers' costs by allowing them to make purchasing decisions quickly and reliably as to whether the item "is made by the same producer . . . he or she liked (or disliked) in the past." *Qualitex*, 514 U.S. at 164.

The Fifth Circuit's decision threatens these economic interests and Congressional goals by severely limiting, and perhaps even effectively eliminating, the protection of product trade dress. As discussed *supra* at 17-18, few, if any, product trade dresses are composed of only "non-functional" features. Moreover, the Fifth Circuit's decision upsets the balance embodied in the "functionality" doctrine, as crafted and applied by this Court and the courts of appeals, between the pro-competitive and pro-consumer benefits provided by the Lanham Act and the fact that "copying is not always discouraged or disfavored by the laws which preserve our competitive economy." *TrafFix*, 532 U.S. at 29 (citing *Bonito Boats, Inc.* v. *Thunder Craft Boats, Inc.*, 489 U.S. 141, 160 (1989)); see, *e.g.*, *Sicilia Di R. Biebow*, 732 F.2d at 422 ("The [functionality] doctrine acts to separate those configurations that may be protected as property rights or trademarks and those designs that the law will not permit any person to monopolize.") (citing *Inwood*).

If left unresolved, the circuit conflict will not only permit a lack of uniformity to exist in the legal standards governing trade dress -- thus leading to inconsistent results and likely forum shopping by litigants – but also sow doubt and

confusion among product manufacturers and distributors as well. Investments in design quality and maintenance will be discouraged or deterred by the uncertainty surrounding whether a product's trade dress will be protectable or enforceable against a predator company seeking to appropriate another company's hard-earned reputation and good will, while that uncertainty will also leave legitimate competitors unsure as to which designs may be copied lawfully.

Of course, at least within the Fifth Circuit, the Court's decision will foster consumer confusion by depriving consumers of the ability to rely upon a particular trade dress to denote the trusted source of the product in question, further undermining important national legislative goals. *Qualitex*, 514 U.S. at 163-64. Indeed, the sort of conduct in which defendants engaged in this case adds nothing of value to our national economy. It does not involve "[r]everse engineering . . . lead[ing] to significant advances in technology," *TrafFix*, 532 U.S. at 29 (internal quotation omitted), but, instead, undermines the purposes of the Lanham Act.

CONCLUSION

For the foregoing reasons, the petition for a writ of certiorari should be granted.

Respectfully submitted,

CARTER G. PHILLIPS
JOSEPH V. JEST
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

PETER J. TOREN*
DAVID TOREN
SIDLEY AUSTIN BROWN & WOOD LLP
787 Seventh Avenue
New York, NY 10019
(212) 839-5300

Counsel for Petitioner

* Counsel of Record

August 22, 2002

APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS
FIFTH CIRCUIT

Nos. 00-60875, 01-60658

EPPENDORF-NETHELER-HINZ GMBH,
Plaintiff-Appellee-Cross-Appellant,

v.

RITTER GMBH; RK MANUFACTURING, INC.,
Defendants-Appellants-Cross-Appellees.

EPPENDORF-NETHELER-HINZ GMBH,
Plaintiff-Appellee,

v.

RITTER GMBH; RK MANUFACTURING, INC.,
Defendants-Appellants.

April 22, 2002

Appeals from the United States
District Court for the
Southern District of Mississippi

Before JONES and DeMOSS, Circuit Judges, and FELDMAN,[1] District Judge.

---

[1] United States District Judge of the Eastern District of Louisiana, sitting by designation.

EDITH H. JONES, Circuit Judge:

Defendants-Appellants Ritter GMBH and RK Manufacturing, Inc., appeal the district court's judgment that they infringed upon Eppendorf-Netheler-Hinz GMBH's trade-dress rights in violation of the Lanham Act, 15 U.S.C. § 1125(a). For the reasons discussed below, we conclude that Eppendorf failed to carry its burden of proof on the issue of non-functionality, and reverse the judgment of the district court.

I. BACKGROUND

Eppendorf is a German company which manufactures medical and laboratory equipment. At issue in this case is Eppendorf's line of disposable pipette tips[2] and dispenser syringes capable of accurate and rapid "multiple dispensing" of liquids. Eppendorf's disposable pipette tips are sold in the United States marked with the word-marks "COMBITIPS," "EPPENDORF" and "EPPENDORF COMBITIPS" (hereinafter referred to as "Combitips"). Eppendorf manufactures eight Combitip sizes, from .05 milliliters to 50 milliliters. All eight sizes are designed to fit into the "Combitip Dispenser Syringe". By attaching a Combitip to the dispenser syringe, a user can rapidly dispense liquids in precisely measured aliquots.

Ritter is a German manufacturer specializing in injection-molded plastic products. In the early 1990s, Ritter began manufacturing disposable pipettes virtually identical to the Combitips. At that time, there was a large American market for disposable pipettes, and the market was dominated by

---

[2] Pipette tips attach to dispenser syringes, and are frequently replaced to avoid contamination. Pipette tips are commonly known in the marketplace as "tips".

Eppendorf.[3] Ritter, through its American distributor, RK Manufacturing, Inc., entered the American market in March of 1994. Ritter's disposable pipettes were marked with the word-mark "RITIPS" (hereinafter "Ritips") and distributed in boxes marked with Ritips and Ritter's name. Ritter also introduced its own dispenser syringe, known in the market as the "Ripette". However, the Ritips were compatible with Eppendorf's Combitip Dispenser Syringe, and the Ritips were marketed as a "direct replacement" for Combitips. Ritter priced its Ritips below Eppendorf's Combitips in an attempt to acquire market share from Eppendorf.

In June of 1998, Eppendorf filed suit in the Eastern District of New York against Ritter and RK, asserting various trademark and trade dress infringement claims under § 43(a) of the Lanham Act, 15 U.S.C. § 1125(a). Eppendorf's suit was transferred to the Southern District of Mississippi. Eppendorf alleges that Ritter infringed on its trade dress rights by "slavishly mimick [ing]" the design and trade dress of the "entire family of Eppendorf [Combitips]." *Second Amended Complaint* at 6. Eppendorf contends that Ritter infringed upon eight elements of the Combitips's trade dress: (1) the flange on top of the tip; (2) the fins connecting the flange to the body of the tip; (3) the plunger head; (4) the plunger; (5) the length of the tips; (6) the eight sizes of the tips; (7) the coloring scheme on the tips; and (8) the angle of the stump on the tips. Eppendorf also contends that Ritter willfully and intentionally infringed upon its trade dress rights.

In June of 2000, Eppendorf's claims were tried before a jury in the Southern District of Mississippi. The jury returned a verdict for Eppendorf, finding that Ritter and RK infringed

---

[3] According to the trial testimony, Eppendorf had sold over 10 million Combitips in the United States by 1989. Over the past 20 years, Eppendorf has sold almost 150 million Combitips.

upon Eppendorf's trade dress rights. The jury also determined that Ritter and RK willfully violated Eppendorf's trade dress rights by marketing the Ritips with an intent to confuse or deceive. The jury awarded Eppendorf $750,000 in lost profits and $250,000 in lost licensing fees. The district court entered final judgment for Eppendorf for $1,000,000 in damages awarded by the jury, and an additional $750,000 in enhanced damages on the basis of the jury's finding of willful infringement. The district court also permanently enjoined Ritter and RK from selling or marketing in the United States dispenser syringes or syringes of "a confusingly similar design" to Eppendorf's syringes.

Ritter and RK now appeal. They contend, *inter alia*, that Eppendorf failed to carry its burden of proving that the eight elements are non-functional. Eppendorf cross-appeals the district court's denial of its motion for attorneys' fees and pre-judgment interest. For the reasons discussed below, we conclude that Eppendorf failed to carry its burden of proving non-functionality and find it necessary to reverse the judgment of the district court.

II. DISCUSSION

A.

The Lanham Act, 15 U.S.C. § 1125(1), establishes a cause of action for trade dress infringement. "Trade dress" refers to the design or packaging of a product-which serves to identify the product's source. *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 28, 121 S.Ct. 1255, 1259, 149 L.Ed.2d 164 (2001). The purpose of trade dress protection, like trademark protection, is to "secure the owner of the [trade dress] the goodwill of his business and to protect the ability of consumers to distinguish among competing products." *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774, 112 S.Ct. 2753, 2760, 120 L.Ed.2d 615 (1992) (citation omitted).

Trade dress protection, however, is not intended to create patent-like rights in innovative aspects of product design. Trade dress protection, unlike patent law, does not foster innovation by preventing reverse engineering or copying of innovative product design features. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 6:3 (4th ed. 2001) ("Unlike patent law, the purpose of trademark and trade dress law is to prevent customer confusion and protect the value of identifying symbols, not to encourage invention by providing a period of exclusive rights."). "Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products." *TrafFix*, 532 U.S. at 29, 121 S.Ct. at 1260. Therefore, trade dress protection extends only to incidental, arbitrary or ornamental product features which identify the source of the product. If a product feature is functional, it cannot be protected trade dress. Unless protected by patent or copyright, functional product features may be copied freely by competitors in the marketplace. *Id.* "Allowing competitors to copy will have salutary effects in many instances. 'Reverse engineering . . . often leads to significant advances in technology.'" *Id.* (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 160, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989)).

The Lanham Act expressly limits the scope of trade dress protection by providing that "the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional." 15 U.S.C. § 1125(a)(3). The requirement of non-functionality "prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature." *Qualitex Co. v. Jacobson Products Co., Inc.*, 514 U.S. 159, 164, 115 S.Ct. 1300, 1304, 131 L.Ed.2d 248 (1995). "Protection of functional product features is the province of patent law, which confers a

monopoly over new product designs for a limited time only, after which competitors are free to copy at will." *Abercrombie & Fitch Stores, Inc. v. American Eagle Outfitters, Inc.*, 280 F.3d 619, 640 (6th Cir.2002) (citing *Qualitex*, 514 U.S. at 164, 115 S.Ct. 1300).

It is clear that functional product features do not qualify for trade dress protection. However, the definition of "functionality" has not enjoyed such clarity. *See* J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 7:67 (4th ed. 2001) (discussing the "plethora of definitions" for functionality). In *TrafFix*, the Supreme Court recognized two tests for functionality. First, the Court recognized the "traditional" definition of functionality: "a product feature is functional, and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of an article.'" *TrafFix*, 532 U.S. at 32, 121 S.Ct. 1255 (citations omitted). Under this traditional definition, if a product feature is "the reason the device works," then the feature is functional. *Id.* at 34, 121 S.Ct. 1255. The availability of alternative designs is irrelevant. *Id.* at 33-34, 121 S.Ct. 1255.

In addition to the traditional definition, *TrafFix* recognized a second test for functionality: "a functional feature is one the 'exclusive use of which would put competitors at a significant non-reputation-related disadvantage.'" *Id.* at 32, 121 S.Ct. 1255 (quoting *Qualitex*, 514 U.S. at 165, 115 S.Ct. 1300). This "competitive necessity" test for functionality is an expansion of the traditional test. *Id.* The Court emphasized, however, that the "competitive necessity" test is not "a comprehensive definition" of functionality. *Id.* at 33, 121 S.Ct. 1255. The primary test for functionality is the traditional test, and there is no need to consider the "competitive necessity" test where a product feature is functional under the traditional definition. *Id.* at 33-35, 121 S.Ct. 1255.

Eppendorf correctly argues that before *TrafFix*, this circuit had adopted a "utilitarian" test of functionality. Under this utilitarian test, "[t]he ultimate inquiry concerning functionality [ ] is whether characterizing a feature or configuration as protected 'will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods.'" *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 429 (5th Cir.1984) (citation omitted); *see also*, *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 537-38 (5th Cir.1998); *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 246, 255 (5th Cir.1997). This court's "utilitarian" test, with its focus on the ability of competitors to compete effectively in the marketplace, is virtually identical to the "competitive necessity" test discussed in *TrafFix*. Accordingly, *TrafFix* supersedes the definition of functionality previously adopted by this court. The "utilitarian" test, although still valid as a secondary test, is not a comprehensive definition of functionality. *TrafFix*, 532 U.S. at 32-33, 121 S.Ct. 1255. In light of *TrafFix*, the primary test for determining whether a product feature is functional is whether the feature is essential to the use or purpose of the product or whether it affects the cost or quality of the product. *Id.*[4]

B.

The crucial issue presented by this appeal is whether the eight design elements of the Eppendorf Combitips are

---

[4] This court noted in *Sunbeam* that the utilitarian definition of functionality "lowers the threshold for trade dress protection." 123 F.3d at 255 n. 18. This broad definition of functionality is not consistent with the Court's recent discussion of functionality. The Court, in *TrafFix*, cautioned against "misuse or over-extension of trade dress [protection]." *See TrafFix*, 532 U.S. at 29, 121 S.Ct. 1255 (citing *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 213, 120 S.Ct. 1339, 146 L.Ed.2d 182 (1992)). A product feature that satisfies the traditional definition of functionality is not shielded from functional status merely because the feature is not a competitive necessity.

functional as a matter of law. This case was tried in June of 2000, almost ten months before the Supreme Court decided *TrafFix*. The district court, correctly applying this circuit's utilitarian test of functionality, instructed the jury as follows:

> A design or characteristic is nonfunctional if there are reasonably effective and efficient alternatives possible. Hence, a product's trade dress is functional only, one, if competitors need to incorporate it in order to compete effectively because it is essential to the product's use, or, two, if it significantly affects the cost or quality of the article. A design is functional and thus unprotectable if it is one of a limited number of equally efficient options available to competitors and free competition would be significantly disadvantaged by according the design trademark protection.

Relying on this instruction, the jury determined that the Combitips were non-functional. Ritter and RK Manufacturing moved for judgment as a matter of law on the issue of functionality, and the district court denied the motion.

"We review *de novo* the district court's ruling on a motion for judgment as a matter of law, applying the same legal standards at the trial court." *Flowers v. Southern Reg'l Physician Serv., Inc.*, 247 F.3d 229, 235 (5th Cir.2001). In reviewing a motion for judgment as a matter of law, "we consider all of the evidence, drawing all reasonable inferences and resolving all credibility determinations in the light most favorable to the non-moving party." *Id.* (citations omitted). Judgment as a matter of law will only be granted where the facts and inferences point "so strongly and overwhelmingly in the movant's favor that reasonable jurors could not reach a contrary conclusion." *Omnitech Int'l, Inc. v. Clorox Co.*, 11 F.3d 1316, 1322 (5th Cir.1994).

Eppendorf contends that the evidence supports the jury's finding of non-functionality because "[t]he evidence clearly

established that there were alternative designs to each of the eight non-functional features." *Appellee's Brief* at 20. Indeed, there is extensive testimony in the record regarding available alternative designs for each of the eight elements. For example, Eppendorf's expert testified that the number of fins under the flange "could be increased or decreased or their appearance could be changed." *Appellee's Brief* at 5. Thus, Eppendorf argues that the fins are non-functional because alternative designs are available to competitors in the marketplace.

Eppendorf's argument, while consistent with this circuit's utilitarian definition of functionality, is unpersuasive in light of the Court's discussion of functionality in *TrafFix*. As explained above, the primary test for functionality is whether the product feature is essential to the use or purpose of the product or if it affects the cost or quality of the product. In *TrafFix*, the Court determined that the dual-spring design on a wind-resistant road sign was functional because the dual-spring design "provides a unique and useful mechanism to resist the force of the wind." 532 U.S. at 33, 121 S.Ct. at 1262. The Court rejected the argument that the springs were non-functional because a competitor could use three or four springs which would serve the same purpose. *Id.* The Court explained,

> There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. . . . The dual-spring design is not an arbitrary flourish in the configuration of [the road sign]; it is the reason the device works. Other designs need not be attempted.

Id. at 33-34, 121 S.Ct. at 1261. Accordingly, the design features for which Eppendorf seeks trade dress rights are functional if they are essential to the use or purpose of the

Combitips or affect the cost or quality of the Combitips. The availability of alternative designs is irrelevant.

In this case it is undisputed that the Combitips's fins provide necessary support for the flange. Without the fins, the flange is subject to deformation. The only testimony offered by Eppendorf to prove non-functionality of the fins related to the existence of alternative design possibilities. Eppendorf's functionality expert testified that the appearance and number of fins could be changed without affecting the function of the fins. Eppendorf did not prove, however, that the fins are an arbitrary flourish which serve no purpose in the Combitips. Rather, Eppendorf's experts concede that fins of some shape, size or number are necessary to provide support for the flange and to prevent deformation of the product. Thus, the fins are design elements necessary to the operation of the product.[5] Because the fins are essential to the operation of the Combitips, they are functional as a matter of law, and it is unnecessary to consider design alternatives available in the marketplace. *TrafFix*, 532 U.S. at 33-34, 121 S.Ct. at 1261.

Likewise, a careful review of the record demonstrates that Eppendorf failed to prove that the remaining Combitip design elements are unnecessary, non-essential design elements. It is undisputed that: (1) The flange is necessary to connect the Combitip to the dispenser syringe; (2) The rings on the plunger head are necessary to lock the plunger into a cylinder in the dispenser syringe; (3) The plunger is necessary to push liquids out of the tip, and the ribs on the plunger stabilize its action; (4) The tips at the lower end of the Combitips are designed to easily fit into test tubes and other receptacles; (5) The size of the Combitip determines the dispensed volume,

---

[5] Additionally, Eppendorf's experts concede that some of the suggested alternative designs would slightly increase the cost of the product. This provides further support for the conclusion that the fins are functional under the traditional definition of functionality.

and size is essential to accurate and efficient dispensing; (6) The color scheme used on the Combitip—clear plastic with black lettering—enables the user easily to see and measure the amount of liquid in the Combitip, and black is standard in the medical industry; and (7) The stumps of the larger Combitips must be angled to separate air bubbles from the liquid and ensure that the full volume of liquid is dispensed. Thus, all eight design elements identified by Eppendorf are essential to the operation of the Combitips.

Eppendorf's theory of non-functionality focused on the existence of alternative designs. Eppendorf's design expert summarized Eppendorf's approach to functionality: "My conclusion was that to achieve the same functional purpose, [the design elements identified by Eppendorf] can be changed significantly, considerably without affecting the overall intended purpose." Although alternative designs are relevant to the utilitarian test of functionality, alternative designs are not germane to the traditional test for functionality. Each of the eight design elements identified by Eppendorf is essential to the use or purpose of the Combitips, and is not arbitrary or ornamental features. Therefore, no reasonable juror could conclude that Eppendorf carried its burden of proving non-functionality.

CONCLUSION

We conclude that Eppendorf failed to carry its burden of proving non-functionality. Therefore, pursuant to 15 U.S.C. § 1125(a)(3), Eppendorf is not entitled to trade dress protection because the eight Combitip product features are functional as a matter of law. Accordingly, we REVERSE the judgment of the district court and RENDER judgment for Ritter and RK Manufacturing. We likewise VACATE the injunction entered by the district court. Eppendorf's cross-appeal is DENIED.

APPENDIX B

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
JACKSON DIVISION

[Filed: Oct 31, 2000]

CIVIL ACTION NO.3:98cv797BN

EPPENDORF-NETHELER-HINZ GMBH,
Plaintiff,

VS.

RITTER GMBH and RK MANUFACTURING, INC.,
Defendant.

FINAL JUDGMENT

On June 30, 2000, a jury composed of David E. Stott and seven other jurors returned their verdict as follows:

A. USE OF THE COMBITIPS PRODUCT DESIGN

1. Do you find that Eppendorf has proven that it used the product design of its combitips syringes as a trade dress prior to defendants' use of their product at the Pittcon conference in Chicago on March 2, 1994?

X Yes ___ No

B. FUNCTIONALITY

2. Do you find that Eppendorf has proven that the product design of Eppendorf's combitips syringes is nonfunctional for each of the following sizes?

0.05 ml	X yes	___ no
0.5 ml	X yes	___ no

1.25 ml	X yes	___ no
2.5 ml	X yes	___ no
5.0 ml	X yes	___ no
12.50 ml	X yes	___ no
25 ml	X yes	___ no
50 ml	X yes	___ no

C. SECONDARY MEANING

3. Do you find that Eppendorf has proven a mental association in consumers' minds between Eppendorf's trade dress and a single source of the product?

0.05 ml	X yes	___ no
0.5 ml	X yes	___ no
1.25 ml	X yes	___ no
2.5 ml	X yes	___ no
5.0 ml	X yes	___ no
12.50 ml	X yes	___ no
25 ml	X yes	___ no
50 ml	X yes	___ no

D. TRADE DRESS FAMILY

4. Do you find that Eppendorf has proven it has a trade dress family in its combitips syringes?

X Yes ___ No

5. If you have answered "Yes" to Interrogatory 4 above, do you find that Eppendorf has proven a mental association in consumers' minds between Eppendorf's trade dress family and a single source of the product?

X Yes ___ No

E. LIKELIHOOD OF CONFUSION

6. Do you find that Eppendorf has proven likelihood of confusion with respect to defendants' ritips product?

0.05 ml	X yes	___ no
0.5 ml	X yes	___ no
1.25 ml	X yes	___ no
2.5 ml	X yes	___ no
5.0 ml	X yes	___ no
12.50 ml	X yes	___ no
25 ml	X yes	___ no
50 ml	X yes	___ no

7. If you have answered "Yes" to Interrogatory 4 above, do you find that Eppendorf has proven a likelihood of confusion with respect to defendants' ritips product and Eppendorf's trade dress family?

X Yes ___ No

F. LACHES

8. Do you find that defendants have proven their affirmative defense of laches by a preponderance of the evidence?

___ Yes X No

G. WILLFULNESS

9. Do you find that Eppendorf has proven that the conduct of Defendant Ritter GmbH, in connection with the marketing of defendants' ritips products, was done with the intent to confuse or deceive or to appropriate any goodwill in Eppendorf's trade dress.

X Yes ___ No

10. Do you find that Eppendorf has proven that the conduct of Defendant RK Manufacturing, Inc., in

connection with the marketing of defendants' ritips products, was done with the intent to confuse or deceive or to appropriate any goodwill in Eppendorf's trade dress.

X Yes ___ No

H. DAMAGES

11. If you have found for Eppendorf, in what amount do you assess its damages:

a. For Eppendorf' s lost profits, if any:
$750,000

b. For defendants' profits, if any:

i. for defendant Ritter
$ -0-

ii. for defendant RK Manufacturing, Inc.
$ -0-

c. for Eppendorf's reasonable license fees, if any:
$250,000

In an opinion and Order dated October 31, 2000, the Motion of the Plaintiff for Enhanced Damages was granted. The jury verdict was increased to $1,750,000.00.

Additionally, in the July 26, 2000, Order Regarding Permanent Relief, Defendant Ritter GmbH was permanently enjoined from selling in the United States, offering for sale in the United States, distributing in the United States, or exporting to the United States, dispenser syringes of Eppendorf-Netheler-Hinz, or dispensers using a confusing similar design. Defendant RK Manufacturing, Inc. was permanently enjoined from selling, offering for sale, distributing or importing into the United States, dispenser syringes using the trade dress of the Combitips dispenser syringes or Eppendorf-Netheler-Hinz GmbH or dispenser syringes using a confusingly similar design.

In accordance with the jury verdict as amended by the grant of the Motion of the Plaintiff for Enhanced Damages, the Court hereby enters final judgment in favor of Plaintiff Eppendorf-Netheler-Hinz GmbH against Defendant Ritter GmbH and Defendant RK Manufacturing, Inc., in the amount of $1,750,000.00.

Further, in accordance with the Order Regarding Permanent Injunctive Relief entered on July 26, 2000, the Court hereby enters final judgment permanently enjoining Defendant Ritter GmbH from selling in the United States, offering for sale in the United States, distributing in the United States, or exporting to the United States, dispenser syringes of Eppendorf-Netheler-Hinz, or dispensers using a confusing similar design. Additionally, the Court hereby enters final judgment permanently enjoining Defendant RK Manufacturing, Inc. from selling, offering for sale, distributing or importing into the United States, dispenser syringes using the trade dress of the Combitips dispenser syringes or Eppendorf-Netheler-Hinz GmbH or dispenser syringes using a confusingly similar design.

SO ORDERED this the 31st day of October, 2000.

/s/ [Illegible]
UNITED STATES DISTRICT JUDGE

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
JACKSON DIVISION

[Filed: Oct 31, 2000]

CIVIL ACTION NO. 3:98cv797BN

EPPENDORF-NETHELER-HEINZ GMBH,
Plaintiff,

VS.

RITTER GMBH and RK MANUFACTURING, INC.,
Defendant.

OPINION AND ORDER

This cause is before the Court on the Motion of the Plaintiff for Enhanced Damages, Prejudgment Interest, and Attorney Fees. Having considered the Motion, Response, Rebuttal, all attachments to each, and supporting and opposing authority, the Court finds that the Motion should be granted in part and denied in part.

I. Factual Background and Procedural History

Eppendorf-Netheler-Hinz GmbH ("Eppendorf") is the manufacturer and distributor of liquid handling devices sold under the word marks COMBITIPS, EPPENDORF, and EPPENDORF COMBITIPS ("COMBITIPS"). Eppendorf alleges that the COMBITIPS product line embodies a family of distinctive and famous design marks and trade dress. Defendant Ritter GmbH ("Ritter") began to manufacture a

line of syringes that allegedly embodied the trade dress of the COMBITIPS "family" in the early 1990s. RK Manufacturing, Inc. ("RK"), as a distributor of Ritter syringes in the United States, first exhibited the Ritter syringes at the Pittcon convention in Chicago, Illinois, in March of 1994.

On June 11, 1998, Eppendorf filed the subject lawsuit alleging trademark and trade dress infringement by Ritter and RK. The case was tried to a jury beginning on June 19, 2000, through June 30, 2000. In a verdict by special interrogatories, the jury found in favor of Eppendorf and awarded $750,000.00 in damages and $250,000.00 in license fees. The Motion of the Plaintiff for Enhanced Damages, Prejudgment Interest, and Attorney Fees is now before the Court.

II. Analysis

A. Enhancement of Damages

Pursuant to section 35 (a) of the Lanham Act, a district court, in its discretion, may "enter judgment, according to the circumstances of the case, for any sum above the amount found as actual damages, not exceeding three times such amount." 15 U.S.C. § 1117(a). An award in excess of actual damages, however, must "constitute compensation and not a penalty." *Id. See also Taco Cabana Int'l Inc. v. Two Peso, Inc.*, 932 F.2d 1113, 1127 (5th Cir. 1992) (holding that an enhancement of damages cannot be punitive in nature). While the "[i]ntentional imitation [of a product] alone" generally will not justify an enhancement of damages, a district court may enhance damages in cases in which one party has willfully infringed the trade dress of the other. *Taco Cabana*, 932 F.2d at 1127.

Having considered all of the evidence presented at trial, this Court finds that an enhancement of damages is warranted in this case. First, the record clearly establishes that the Defendants intentionally copied the product design of the Eppendorf COMBITIPS syringe when creating their line of

liquid dispensing syringes. A visual comparison of the Eppendorf syringe and the Ritter/RK syringe shows that the latter is virtually identical to the former. No attempt was made by the Defendants to alter the design of the: (1) number of rings on the plunger, (2) the fins under the flange, (3) the plunger of the syringe, (4) the length of the syringe, (5) the flange on the syringe, (6) the stump angle, or (7) the color scheme, in spite of the fact that the Defendants were aware that their product design was essentially identical to that of COMBITIPS syringes, that the Plaintiff had contested the use of its product design by the Defendants, and that alterations in the design of the syringe, that could have prevented consumer confusion, were possible. The Court is not convinced that the use by the Defendants of a slightly altered measuring scale on its syringes was adequate to minimize the consumer confusion likely to result from their otherwise blatant copying of the over-all COMBITIPS design. Likewise, the Court is unpersuaded that the inclusion of the trade name "RITIPS" on the syringes manufactured by the Defendants is, without more, sufficient to minimize trade dress confusion given the facts and circumstances of this case.[1]

Second, the Court is unpersuaded by the evidence of Mr. Franz Peter Ritter, the co-founder and head of Ritter GmbH and the cofounder and president of RK. Mr. Ritter testified that he was contacted by a customer that inquired as to whether the Defendants could improve the design of a syringe dispenser allegedly manufactured by the Polish company HTL. Mr. Ritter also testified that he was furnished a photograph of the allegedly leak-prone syringes on which it based its product design. The photograph, however, actually

---

[1] The fact that a product is marketed under a different trade name does not automatically protect the party accused of blatant copying in a trade dress infringement case. *See, e.g., Taco Cabana*, 932 F.2d at 1113 (finding trade dress infringement even though the restaurants were identified by different names).

was of Eppendorf COMBITIPS syringes on which the name "Eppendorf" had been whited-out. The Defendants did not improve the design of the depicted syringes, instead they did no more than copy the design of Eppendorf and distribute their identical syringes under the name "RITIPS." Even if the Court were to credit Mr. Ritter's testimony that he was not aware that the syringes in the photograph were manufactured by Eppendorf, the Defendants had actual knowledge that they had duplicated the syringe system of another manufacturer and sought to profit from their exploits.

Additionally, the Court is unpersuaded by the testimony of Mr. Ritter as regards the legal advice he received from German attorney Mr. Gallo on behalf of his companies. Mr. Ritter's testimony, as it pertains to Mr. Gallo's investigation, was essentially unsupported by other testimony or documentation at trial. Except for the testimony of Mr. Ritter, there is no evidence in the record to indicate the manner or scope of Mr. Gallo's investigation or the content of the findings or opinions that may have been conveyed to the Defendants. There is also no showing that Mr. Gallo was qualified to research trade dress law in the United States, had otherwise consulted with an attorney so qualified, or had even considered the possibility that the United States recognizes trade dress infringement, in addition to trademark and copyright infringement, as a distinct and separate cause of action. In fact, when asked whether the legal opinion of Mr. Gallo specifically mentioned the area of trade dress, Mr. Ritter responded by stating, "If there had been such rights, Mr. Gallo would have told me." *See* Plaintiff's Memorandum in Support of Its Motion for Enhanced Damages, Prejudgment Interest, and Attorney Fees ("Plaintiff's Memorandum"), at 11 (citing Trial Trans. at 1060:16-1061:14). The Court finds that the Defendants have failed to provide sufficient testimony or documentation to support their

allegation that they reasonably relied on the advice of counsel prior to entering RITIPS syringes into the United States market.

Third, the record indicates that prior to the time RITIPS entered markets in the United States, the Defendants knew that their product design was identical to that of Eppendorf and that Eppendorf was the leader of liquid handling syringes used in conjunction with the Eppendorf dispensing system in the United States. The Defendants were also aware that Eppendorf objected to the use of the COMBITIPS design by the Defendants. Even with this knowledge, however, the Defendants made no attempt to alter the design of their product but, instead entered a virtually identical product into the market. The Court finds that "there has been no other plausible explanation presented by the Defendants for the virtual replication of the Plaintiff's [COMBITIPS syringe design]" and, therefore, the Court concludes that the Defendants "intended to imitate the [COMBITIPS syringe design] and thereby benefit from the consumer goodwill associated with [Eppendorf COMBITIPS]." *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 247, 258 (5th Cir. 1997).

The conclusion reached by the Court is supported by the fact that the Defendants advertised RITIPS syringes as a "direct replacement" for Eppendorf COMBITIPS. Pl. EX. 41 (RK advertising) . The Court is not persuaded by the assertion of the Defendants that the reference to RITIPS as "direct replacements" was meant to imply that the RITIPS "product was directly compatible with an Eppendorf or equivalent dispenser without the need for any special adaptor." Defendants' Opposition to Plaintiff's Motion for Enhanced Damages, Prejudgment Interest, and Attorney Fees ("Defendants' Response"), 14. If the Defendants intended to merely convey a "no special adaptor required" message to the American buying public, they could have so provided in their

advertisement. Instead, the Defendants touted their exact replica syringes as being a "direct replacement" for those of the market leader Eppendorf.

The Court finds that the intentional copying by the Defendants of the COMBITIPS syringe design coupled with the claim that RITIPS were a direct replacement for the product manufactured, distributed and heavily advertised by the market leader Eppendorf, amounts to a deliberate infringement with the intent to usurp the goodwill of Eppendorf. In the present case, the Defendants purposefully infringed upon the COMBITIPS trade dress with the intent to steal customers from Eppendorf in the United States market. The Court finds that given the deliberate and intentional acts of the Defendants, and the difficulty in determining the actual amount of damage Eppendorf suffered because of these acts, that an enhancement of damages pursuant to section 35 (a) of the Lanham Act is warranted. Therefore, the Court will award Eppendorf enhancement damages of $750,000.00 which, when added to the damages awarded by the jury, results in total damages awarded of $1,750,000.00.

B. Attorney Fees

Pursuant to section 35 (a) of the Lanham Act, a court may award attorney fees to the prevailing party in "exceptional cases." *See* 15 U.S.C. § 1117(a). Exceptional cases are those in which "the acts of infringement can be characterized as 'malicious,' 'fraudulent,' 'deliberate,' or 'willful.'" *Moore Business Forms, Inc. v. Ryu*, 960 F.2d 486, 491 (5th Cir. 1992) (quoting S. REP. NO. 93-1400 (1974), reprinted in U.S.C.C.A.N. 7132, 7133). *See also, Pebble Beach Co. v. Tour 18 I Limited*, 155 F.3d 526, 555 (5th Cir. 1998). A finding of "willfulness" sufficient to enhance damages, however, does not automatically entitle the successful

Plaintiff to attorneys' fees.[2] *See Taco Cabana*, 932 F.2d at 1127 (refusing to "conflate the standards [for enhanced damages and attorney fees pursuant to 15 U.S.C. § 1117(a)] because some cases may well warrant one form of recovery and not the other"). "An awards of attorneys' fees under [15 U.S.C.] § 1117(a) generally 'requires a showing of a high degree of culpability on the part of the infringer, for example bad faith or fraud.'" *Pebble Beach*, 155 F.3d at 556 (citing *Texas Pig Stands, Inc. v. Hard Rock Cafe Int'l, Inc.*, 951 F.2d 685, 697 (5th Cir. 1992)); *Ryu*, 960 F.2d at 491-92.

To be entitled to attorneys' fees, the prevailing party must prove the "exceptional nature of the case by clear and convincing evidence." *Pebble Beach*, 155 F.3d at 555 (citing *CJC Holdings, Inc. v. Wright & Lato, Inc.*, 979 F.2d 61, 65 (5th Cir. 1992). If the prevailing party satisfies this burden, the court, in its discretion, may award attorneys' fees. *Id.* A district court, however, "normally should not find a case exceptional where the party presents what it in good faith believes may be a legitimate defense." *Id.* at 556. The Court finds that the Defendants presented legitimate defenses against the claims made by Eppendorf. As there is no evidence in the record to support a finding that the Defendants acted fraudulently or in bad faith when defending this action, the Motion of Eppendorf for Attorney Fees is denied.

C. Prejudgment Interest

Section 35 (a) of the Lanham Act, does not specifically address the awarding of prejudgment interest in trade dress infringement actions. *See* 15 U. S. C. § 1117(a). Eppendorf, however, argues that a recovery of prejudgment interest is

---

[2] Additionally, "[a] jury finding of willfulness does not bind the trial court in determining whether [a] case is 'exceptional'; it may, however, serve as a guide." *Texas Pig Stands, Inc. v. Hard Rock Cafe Int'l, Inc.*, 951 F.2d 684, 697 (5th Cir. 1992).

required in this case to ensure that it is fully compensated for the willful acts of the Defendants and to deter the conduct of would-be infringers in the future. The Court finds that as Eppendorf has been awarded enhanced damages, it has been fully compensated and an award of prejudgment interest would be punitive in nature. Therefore, the Motion of Eppendorf for Prejudgment Interest is denied.

III. Conclusion

For the foregoing reasons:

IT IS THEREFORE ORDERED that the Motion of Eppendorf to Enhance Damages [151-1] is well taken and is hereby granted. The Court awards Eppendorf total damages in the amount of $1,750,000.00.

IT IS THEREFORE FURTHER ORDERED that the Motion of Eppendorf for Attorney Fees [151-2] and Prejudgment Interest is not well taken and is hereby denied.

SO ORDERED this the 31st day of October, 2000

/s/ [Illegible]
UNITED STATES DISTRICT JUDGE

APPENDIX D

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

[Filed: May 24, 2002]

No. 00-60875

EPPENDORF -NETHELER- HINZ GMBH,
Plaintiff-Appellee-Cross-Appellant,

v.

RITTER GMBH; RK MANUFACTURING INC.,
Defendants-Appellants-Cross-Appellees.

No. 01-60658

EPPENDORF-NETHELER-HINZ GMBH,
Plaintiff–Appellee,

v.

RITTER GMBH; RK MANUFACTURING INC.,
Defendants–Appellants.

Appeals from the United States District Court
for the Southern District of Mississippi, Jackson

ON PETITION FOR REHEARING EN BANC

(Opinion 4/22/02, 5 Cir., _____, _____F.3d _____)

Before JONES and DeMOSS, Circuit Judges, and FELDMAN*, District Judge.

PER CURIAM:

(X) Treating the Petition for Rehearing En Banc as a Petition for Panel Rehearing, the Petition for Panel Rehearing is DENIED. No member of the panel nor judge in regular active service of the court having requested that the court be polled on Rehearing En Banc (FED. R. APP. P. and 5TH CIR. R. 35), the Petition for Rehearing En Banc is DENIED.

( ) Treating the Petition for Rehearing En Banc as a Petition for Panel Rehearing, the Petition for Panel Rehearing is DENIED. The court having been polled at the request of one of the members of the court and a majority of the judges who are in regular active service not having voted in favor (FED. R. APP. P. and 5TH CIR. R. 35), the Petition for Rehearing En Banc is DENIED.

ENTERED FOR THE COURT:

/s/ Edith H. Jones
United States Circuit Judge

*United States District Judge of the Eastern District of Louisiana sitting by designation.

APPENDIX E

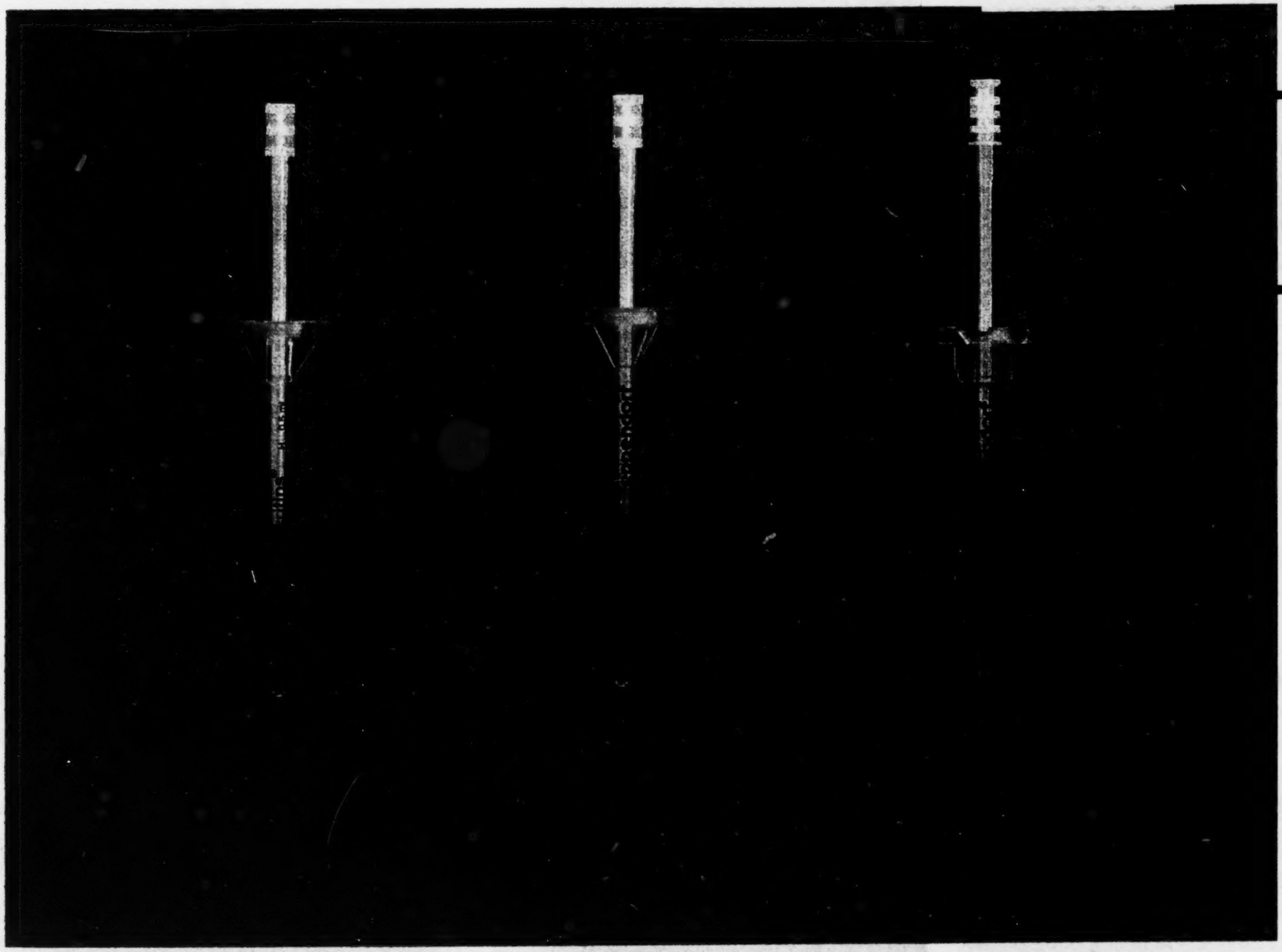
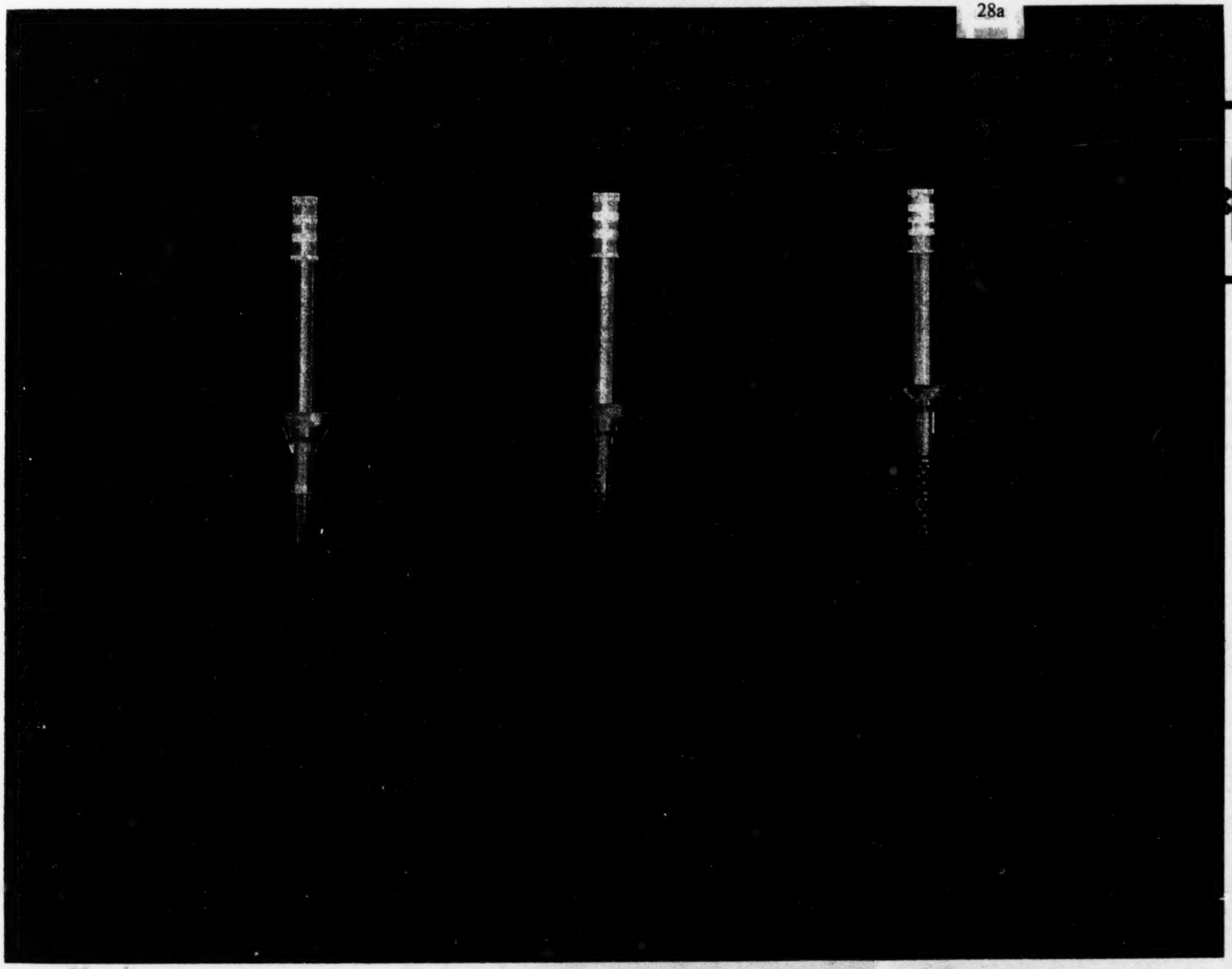
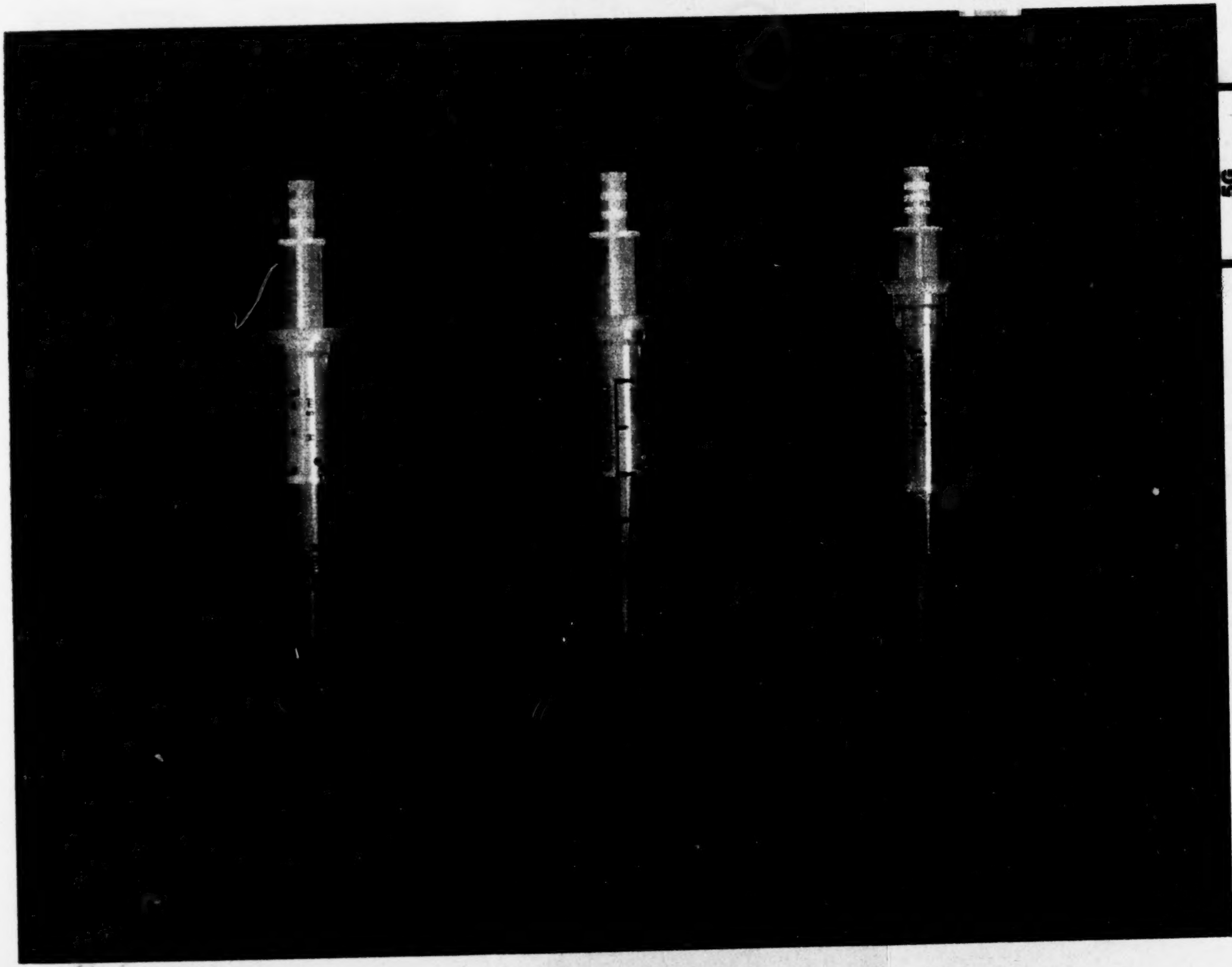
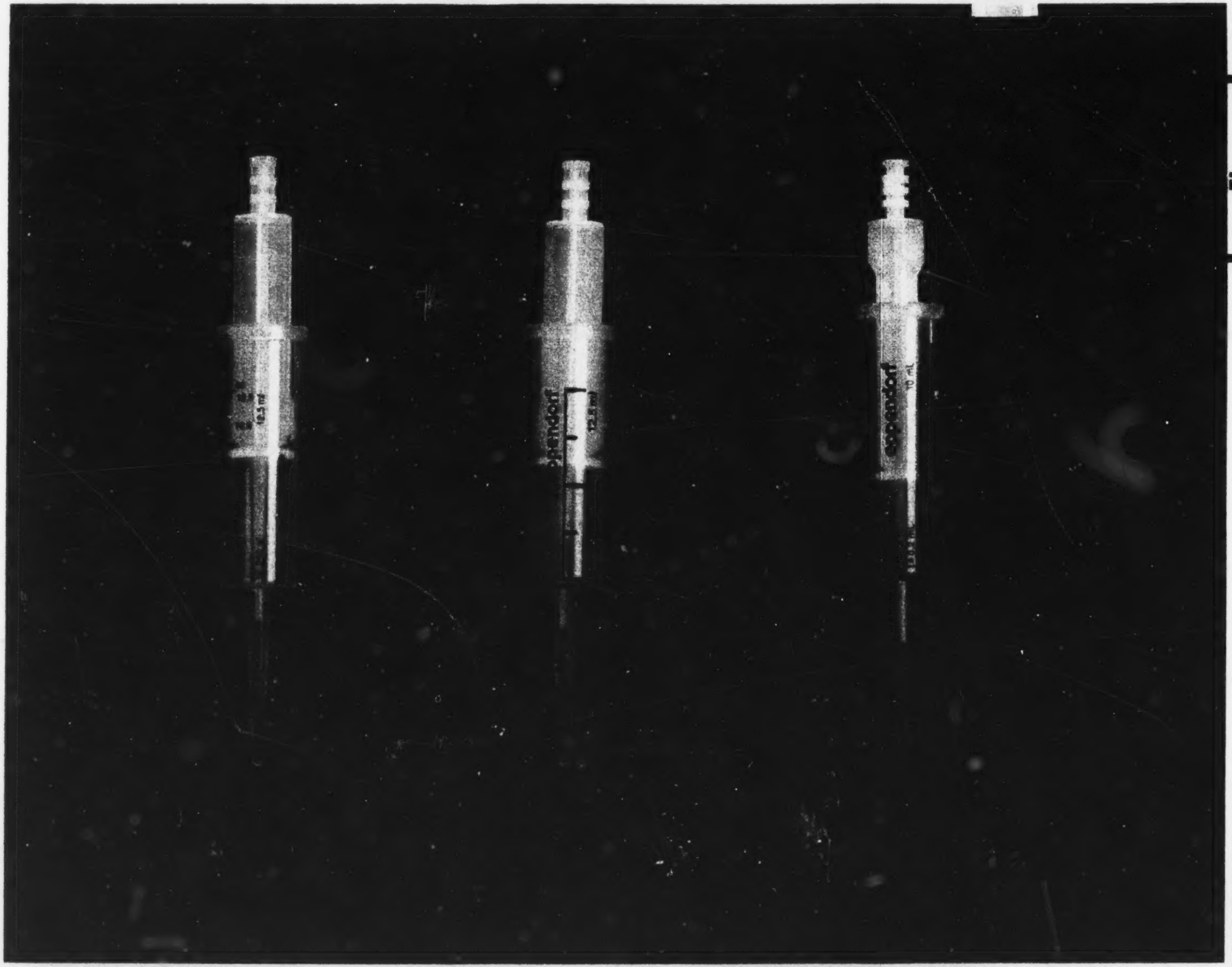


EXHIBIT 5A



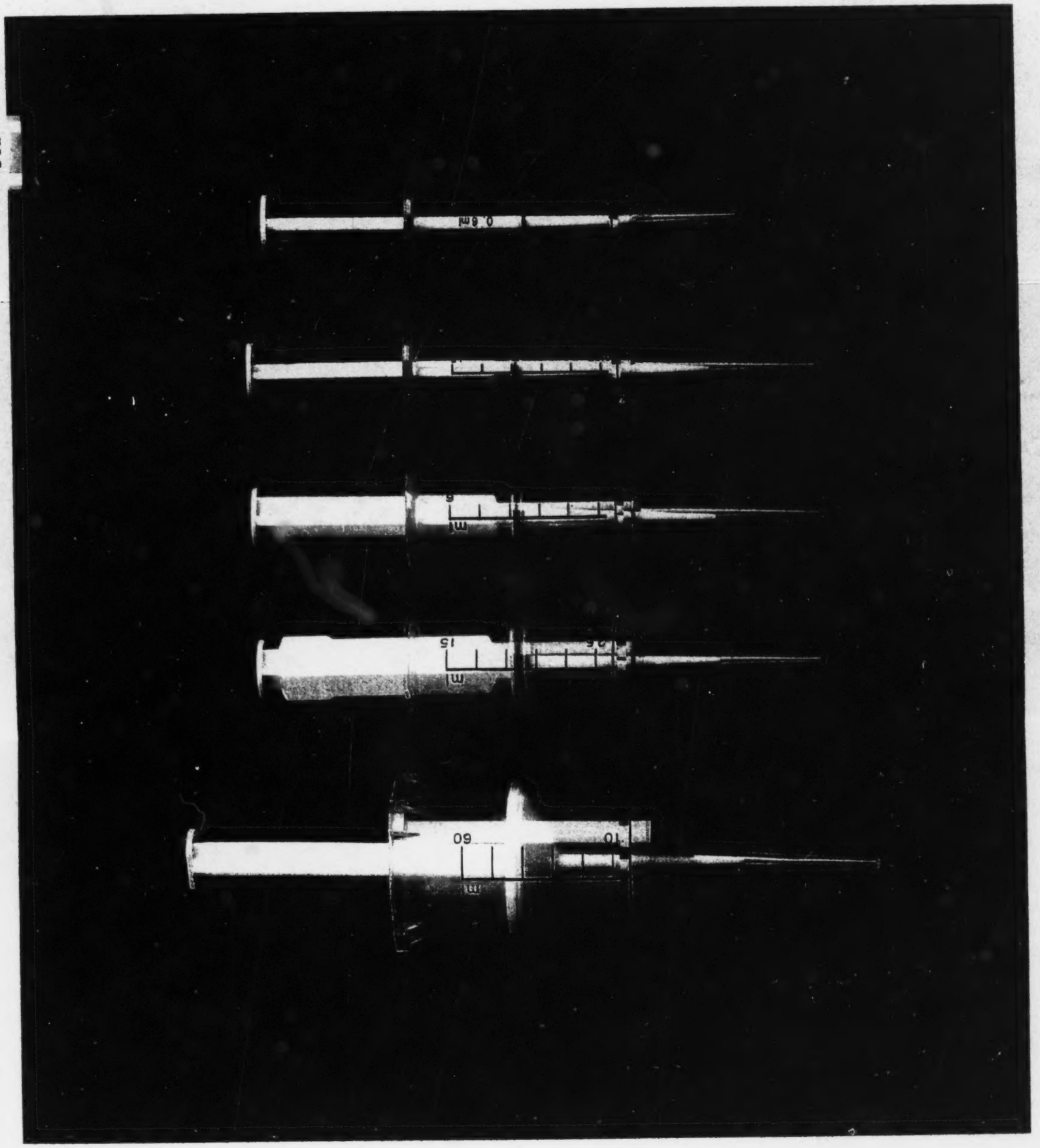


5G



BEST AVAILABLE COPY

PLAINTIFF'S
EXHIBIT
4E



SUPREME COURT, U.S.
FILED
NOV 6 2002
CLERK

No. 02-300

IN THE

Supreme Court of the United States

EPPENDORF-NETHELER-HINZ GMBH,

Petitioner,

v.

RITTER GMBH AND RK MANUFACTURING, INC.

Respondents.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Fifth Circuit

BRIEF FOR RESPONDENTS IN OPPOSITION

WILLIAM J. UTERMOHLEN
OLIFF & BERRIDGE, PLC
277 South Washington Street
Suite 500
Alexandria, Virginia 22314
(703) 836-6400

Counsel for Respondents

RULE 29.6 STATEMENT

Neither Ritter GmbH nor RK Manufacturing, Inc. have parent companies or publicly traded subsidiaries.

TABLE OF CONTENTS

		Page
OPINION BELOW		1
STATEMENT OF THE CASE		1
SUMMARY OF ARGUMENT		7
ARGUMENT		8
I.	THERE IS NO CIRCUIT CONFLICT	8
II.	THERE IS NO NEED FOR THIS COURT TO RECONSIDER THE *TRAFFIX* CASE	10
CONCLUSION		16

TABLE OF AUTHORITIES

Page

Cases

Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4 (2d Cir. 1976) 11

Eppendorf-Netheler-Hinz GmbH v. Enterton Co. Establishment, 89 F. Supp. 2d 483 (S.D.N.Y. 2000), *aff'd*, 14 Fed. Appx. 102 (2d. Cir. 2001) 3

Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982) 8, 11, 12

QualitexCo. v. Jacobson Products Co., 514 US 159 (1995) 11

Seabrook Foods, Inc. v. Bar-Well Foods, Ltd., 568 F.2d 1342 (C.C.P.A. 1977) 11

Sunbeam Prods., Inc. v. Westbend Co., 123 F.3d 246 (5th Cir. 1997) 15

TrafFix Devices, Inc. v. Marketing Displays, Inc., 532 U.S. 23 (2001) ..... passim

Valu Engineering, Inc. v. Rexnord Corp., 278 F.3d 1268 (Fed. Cir. 2002) 7, 9

Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205 (2000) 11, 13, 14, 15

Statute

15 U.S.C. § 1125(a)(3) 14

Rule

S. Ct. R. 15.2 4

OPINION BELOW

The opinion of the United States Court of Appeals for the Fifth Circuit is reported both at 289 F.3d 351 and at 62 USPQ2d 1534.

STATEMENT OF THE CASE

During the 1980s, petitioner Eppendorf-Netheler-Hinz GmbH ("Eppendorf") introduced into the American market a mechanical dispenser used to dispense liquids repetitively. Eppendorf also marketed disposable plastic syringes (sometimes called "pipette tips") that fit into the Eppendorf dispenser and hold the liquids to be dispensed. The Eppendorf dispenser became widely distributed among users of such syringes, such as hospitals and laboratories. DX151, DX453, T.648.

In 1990, a Polish company, HTL, introduced in the U.S. the first competitive dispenser syringes that were compatible with the Eppendorf dispenser. DX36. The HTL syringes were unmarked and were of the same basic design as the Eppendorf syringes. T.748/13-22. By 1994, HTL had about 15% of the U.S. market. DX337.

In the early 1990s, respondent Ritter GmbH ("Ritter"), a German company with expertise in injection molding, was approached by two companies who desired an alternative source of supply for such syringes. T.212/6-17, 975/23-982/11, 144/1-6. After Ritter's counsel confirmed that no company had registered any rights in such products, T.981/19-25; 997/19-998/1, 998/18-25, Ritter began making and selling a similar dispenser syringe in Europe in 1993, marked with the brand name "RITIPS," and priced below Eppendorf's product. T.187/7-8, 975/23-982/11, 144/1-6, PX2, DX28. Not long afterwards, Ritter also began

marketing its own dispenser, which, although much different in general appearance from that of Eppendorf, used the same basic interface arrangement, so that the syringes of all three companies could be used interchangeably. PX17.

Eppendorf soon became aware of the Ritter syringe and visited Ritter in November 1993. T.144/1-6; DX76. DX337. Over the next year, a series of negotiations occurred about a potential sale of Ritter's syringe business to Eppendorf. In the meantime, Ritter introduced its dispenser syringes into the American market in March 1994. DX452:90/22-91/17; T.747/2-17. Eppendorf never claimed at such meetings to have trade dress rights in its syringe product configuration. T.155/5-20. Indeed, Eppendorf personnel testified that they did not then believe they had any such rights. Eppendorf's marketing director Michael Schroeder described the discussions:

Q. Did you make any reference to any rights that Eppendorf had?

A. No.

Q. Did you consider yourself to have any rights with respect to Ritter and RK in the United States at that time?

A. No.

DX452:98/7-25, 99/8-100/2. The sale discussions ended in November 1994. DX440; T.149/7-24.

In response to the additional competition, Eppendorf provided "private label" syringes to three large scientific product distributors, which syringes were not identified as originating with Eppendorf. DX38. A number of additional

companies, including Brand, Gilson/Rainin, Jencons and Nichiryo, also began marketing what became known as "generic" syringes: syringes, like respondents', compatible with the typical dispenser interface. DX151:17. Each of those syringes were of the same basic design as the Eppendorf, HTL and Ritter syringes. DX140-48, 394-95.

On June 10, 1998, more than four years after introduction of the Ritter product in the United States and without any prior warning, Eppendorf brought this suit against both Ritter and Ritter's U.S. distributor, RK Manufacturing, Inc. ("RK"), asserting, *inter alia*, a trade dress product configuration claim under the Lanham Act. R.6; T.158/3-10; 752/7-9.

At the same time Eppendorf sued Ritter, Eppendorf also brought suit against the American distributor for HTL. That suit was dismissed on summary judgment on the ground of laches. *Eppendorf-Netheler-Hinz GmbH v. Enterton Co. Establishment*, 89 F. Supp. 2d 483 (S.D.N.Y. 2000), *aff'd*, 14 Fed. Appx. 102 (2d. Cir. 2001).

The suit against Ritter and RK proceeded to trial in June 2000 before the United States District Court for the Southern District of Mississippi. Eppendorf asserted that its dispenser syringes had a non-functional trade dress, with recognized secondary meaning, and that customers were likely to be confused as to origin by the configuration of respondents' "RITIPS" dispenser syringes. Respondents denied those assertions and contended, *inter alia*, that Eppendorf's alleged trade dress claims were subject to laches and estoppel, and that any such rights had been abandoned.

A jury found in favor of Eppendorf and respondents' post-trial motions were denied. Pet. App. 12a-15a.[1]

Ritter and RK appealed to the United States Court of Appeals for the Fifth Circuit, which ruled, on April 22, 2002, that Eppendorf had failed to establish the non-functionality of its alleged trade dress. In reaching its decision, the panel relied on this Court's decision in *TrafFix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001). The Fifth Circuit rejected Eppendorf's petition for rehearing en banc on May 24, 2002, no judge having requested a poll. App. 26a.

Pursuant to S. Ct. R. 15.2, respondents note the following misleading or inaccurate statements of fact in Eppendorf's petition:

1. Eppendorf's alternative design evidence (*see* Pet. 7) was based largely on the Combitips Plus, its second generation dispenser syringe product, which had a pattern of bumps provided on the flange in order to allow Eppendorf's new dispenser to automatically sense the size of inserted syringe. T.393/4-394/4, 1341/2-11, 1347/2-11; DX151:16. The fins were also much larger than in the original Combitips, and provided with a notch, in order to permit the syringes to be set in a rack with that profile. T.363/16-24, 395/9-16. Accordingly, the alternatives posited were designed differently for a functional reason.

2. As to every alleged trade dress element asserted by Eppendorf (*see* Pet. 9), the design choice reflected in its dispenser syringes was the simplest design available. Simplicity is functional, as Eppendorf's witness Dr. Husar admitted: "I think it is always desirable to have a

---

[1] Petitioner has omitted to include the district court's October 25, 2000 ruling on those motions in its Appendix.

simple design." T.393/16-19. Injection-molded plastic parts are produced with steel molds cut into the proper shape by machinists; good design criteria are to use simple geometric shapes, without overhangs, that can most easily be cut into the mold and which will use a minimum amount of plastic consistent with function. T.1224/16-1225/7, 1231/10-14.

3. Alternative design approaches to Eppendorf's asserted elements (*see* Pet. 7-9 & n.4) were not readily available. For example, Ritter's syringes had to be compatible with the Eppendorf dispenser, since many customers already had that dispenser. T.393/11-15; DX151:17. The fill lever of the Eppendorf dispenser had a set travel distance, which limited the length of the liquid holding receptacle of the syringe. T.1228/7-12. Given the volume of the syringe, the basic dimensions of the barrel were thus predetermined.

Volumes could not vary arbitrarily, because there was a lockstep relationship between the overall volume of the syringe and the five different dispensing volumes that could be dispensed on the five settings of the dispenser (the smallest setting being $1/50^{th}$ and the largest being $1/10^{th}$ of the overall volume). T.419/6-423/14; DX419, 450. Moreover, certain dispensing volumes were the ones most popular with customers. For that reason, the 5 ml syringe was by far the most popular size. DX416; T.1119/6-7. Eppendorf tried to change one of its syringe sizes in the move from the Combitips to Combitips Plus (12.5 ml to 10 ml), but the result was that it could not discontinue the Combitips size because there were still customers that wanted the volumes that could only be gotten from that size syringe. T.1129/6-1130/21.

The tips below the barrel had to be compatible with customers' test tubes. Indeed, when Eppendorf tried to

change the length of the 5 ml Combitips Plus, there were so many customer complaints that the change had to be rescinded. DX453:1987; T.1121/19-1122/8. Similar constraints applied to the other asserted elements.

4. Eppendorf's advertising did not focus on the appearance of its dispenser syringes. (Pet. 5). Rather, pictures of its syringes were included in advertisements that focused on the utilitarian purposes of such syringes. PX27, 29 & 33.

5. The reference to the RITIPS as being direct replacements to the Eppendorf syringe (Pet. 6) meant that the RITIPS were compatible with the Eppendorf dispenser, or other standard dispensers, permitting customers to switch between the product lines. DX149. Eppendorf's claim that the use of the term "direct replacement" was false advertising was dismissed by the district court, and not appealed.

6. Eppendorf's evidence of secondary meaning (Pet. 7) was very weak, despite its dominance of the market. Eppendorf relied on a survey that, even after counting identifications that failed to point to any physical aspect of the appearance of the product and could have simply been based on Eppendorf's well-known name, claimed only a 22% recognition of Eppendorf's trade dress. DX446; T.536/23-537/8, T.547/3-21, T.959/3-13. Another 22% of survey respondents identified, as the source of the Eppendorf syringe, companies that do not even make such dispenser syringes. T.542/7-18; DX446.

7. The photograph of Oxford syringes that is attached to the petition without explanation (*see* Pet. 7 n.3; Pet. App. 31a) does not show syringes that were compatible with the Eppendorf dispenser. DX442; T.534/18-536/3, 548/5-550/12, 1130/22-1131/14; DX151:17.

8. Respondents did not deny having copied Eppendorf's product. *See, e.g.*, T.603/1-4, 975/23-982/24. Moreover, the photograph showing syringes from which the name "eppendorf" had been removed was not "one of [respondents'] own documents," but a photograph that had been provided to Ritter by a customer to describe the type of products that the customer desired Ritter to make. PX91; T.1065/3-16.

SUMMARY OF ARGUMENT

There is no conflict between the decision of the Fifth Circuit in this case and the decision of the Federal Circuit in *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002). The Federal Circuit affirmed a finding of functionality by the Trademark Trial and Appeal Board and, accordingly, did not hold that non-functionality may be proven solely by evidence of hypothetical alternative designs.

The Fifth Circuit below applied this Court's guidance expressed in *TrafFix* and did not misinterpret that decision. Rather, petitioner has misinterpreted that decision as having no relevance outside the context of product designs formerly covered by a utility patent. Petitioner's contentions are an attempt to reargue the issues laid to rest in *TrafFix* and the issues petitioner seeks to raise would not be dispositive of this case.

ARGUMENT

I. THERE IS NO CIRCUIT CONFLICT

1. In *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 850 n.10 (1982), this Court articulated the traditional test for functionality of a product feature alleged to have a trade dress, i.e., that such a feature is functional and cannot serve as a trademark "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article." The decision of the Fifth Circuit in this case simply applied the teaching of *TrafFix* that where a plaintiff fails to meet his burden of establishing non-functionality under that traditional rule, the availability of alternative designs is irrelevant. To that end, the Fifth Circuit quoted from a paragraph in this Court's opinion in *TrafFix*:

> There is no need, furthermore, to engage, as did the Court of Appeals, in speculation about other design possibilities, such as using three or four springs which might serve the same purpose. . . . Here, the functionality of the spring design means that competitors need not explore whether other spring juxtapositions might be used. The dual spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

532 U.S. at 33-34. *See* 289 F.3d at 357 (Pet. App. 9a). The Fifth Circuit summarized the evidence that each of the elements on which Eppendorf relied were functional, noted that Eppendorf's "theory of non-functionality focused on the existence of alternative designs," and concluded that "no reasonable juror could conclude that Eppendorf carried its

burden of proving non-functionality." 289 F.3d at 357-58 (Pet. App. 10a-11a).

2. Eppendorf points to the decision of the Federal Circuit in *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002), as allegedly being in conflict with the Fifth Circuit's ruling in this case. However, the Federal Circuit's *Valu Engineering* decision *affirmed* the Trademark Trial and Appeal Board's refusal to register, on functionality grounds, product designs for conveyor guide rails. Accordingly, the Federal Circuit's decision does not stand for the proposition that non-functionality can be established solely through hypothesizing alternative designs. Rather, both circuits are in agreement that, on the facts in the cases before them, the proponents of non-functionality failed to meet their burden of proof.

The Federal Circuit indicated, in dicta, that the Board's having considered, as a factor *favoring* functionality, the unavailability to competitors of functionally equivalent designs was not error. *See* 278 F.3d at 1272 (describing Board's finding) & 1276. The Federal Circuit also indicated, however, consistent with both *TrafFix* and the Fifth Circuit's decision in this case, that a "feature cannot be given trade dress protection merely because there are alternative designs available." *Id.* at 1276.

3. Petitioner brought its contentions about the significance of the Federal Circuit's comments in *Valu Engineering* to the attention of the Fifth Circuit by a February 6, 2002 letter, but the Fifth Circuit did not even mention that decision in its opinion, presumably recognizing that nothing in the Federal Circuit's decision was relevant to resolution of the present case. Petitioner again raised those

contentions unsuccessfully to the Fifth Circuit in its petition for rehearing en banc.[2]

II. THERE IS NO NEED FOR THIS COURT TO RECONSIDER THE *TRAFFIX* CASE

1. Eppendorf's petition is, in effect, a request for rehearing of the *TrafFix* case, not a demonstration that the Fifth Circuit deviated from the guidance this Court provided in *TrafFix*. Petitioner seeks to construe the *TrafFix* decision as limited solely to the context of alleged trade dress features formerly covered by a utility patent. *See* Pet. 13-14, 18-19. In other words, petitioner would like to read Part III out of the *TrafFix* opinion.

In Part III of *TrafFix*, Justice Kennedy, for a unanimous Court, indicated that the Court of Appeals' failure to give sufficient recognition to the evidentiary significance of the expired utility patents "likely was caused by its misinterpretation of trade dress principles in other respects." 532 U.S. at 32. In Part II of the opinion, the Court had given an example of how non-functionality could be established:

> Where the expired patent claimed the features in question, one who seeks to establish trade dress protection must carry the heavy burden of showing that the feature is not functional, for instance by showing that it is merely an ornamental, incidental, or arbitrary aspect of the device.

---

[2] Petitioner's assertion that the resolution of the functionality issue is "outcome determinative" because the Fifth Circuit's reversal was based solely on that ground, Pet. at 16, ignores the additional issues respondents raised before the Fifth Circuit that were mooted by that court's ruling as to functionality. *See* Br. Applts. at 1-2.

Id. at 30.[3] The Court returned to that thought in Part III of its opinion, which manifestly was not limited to the expired utility patent context:

> The dual-spring design is not an arbitrary flourish in the configuration of MDI's product; it is the reason the device works. Other designs need not be attempted.

Id. at 34. The Court further commented that even the existence of a utility patent would not necessarily suggest functionality as to "arbitrary, incidental, or ornamental aspects of features of a product found in the patent claims, such as arbitrary curves in the legs or an ornamental pattern painted on the springs." However, the Court explained that "MDI has pointed to nothing arbitrary about the components of its device or the way they are assembled." The *TrafFix* opinion thus repeatedly pointed to the existence or absence of arbitrary, incidental or ornamental aspects of an alleged product configuration trade dress as reliable indicia of whether or not the trade dress is functional.

Moreover, the *TrafFix* decision made very clear that where, as here, aesthetic functionality is not the issue, substitution of the *Qualitex* "significant non-reputation-related disadvantage" analysis, or any similar analysis, for the traditional test articulated in *Inwood* is not appropriate:

---

[3] This ornamental, incidental, or arbitrary terminology harks back, of course, to the seminal definition of trademarks provided in *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 10-11 (2d Cir. 1976), which treated "arbitrary," "fanciful" or "suggestive" word marks as inherently distinctive. "Ornamental" was a term applied to product packaging in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 1344 (C.C.P.A. 1977). *See Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210-14 (2000).

> Where the design is functional under the *Inwood* formulation there is no need to proceed further to consider if there is a competitive necessity for the feature.

532 U.S. at 33. Again, this clarification was expressly made applicable regardless of the presence or absence of a utility patent:

> Whether a utility patent has expired or there has been no utility patent at all, a product design which has a particular appearance may be functional because it is "essential to the use or purpose of the article" or "affects the cost or quality of the article."

Id. at 35. The Fifth Circuit was, thus, correct to reject application to this case of its "utilitarian" test, which it characterized as "virtually identical to the 'competitive necessity' test discussed in *TrafFix*." 289 F.3d at 356 (Pet. App. 7a).

The Fifth Circuit concluded that "[e]ach of the eight design elements identified by Eppendorf is essential to the use or purpose of the Combitips, and are not arbitrary or ornamental features."[4] That conclusion was based on the test re-emphasized in *TrafFix* and the factors considered germane by *TrafFix*. Petitioner's assertion that the Fifth Circuit departed from this Court's opinion in *TrafFix* is without merit.

2. Petitioner's remaining arguments are an attack on the principles enunciated in *TrafFix* as allegedly sounding

---

[4] So in original and in the version published at 62 USPQ2d 1534, 1538. The version published in F.3d and repeated in the petitioner's appendix (11a) substitutes "is not arbitrary" for "are not arbitrary."

the death knell of product design trade dress protection. However, that attack is both based on a myopic view of the role of product design trade dress and fails to identify any actual problems that have arisen to date on account of the Court's analysis in *TrafFix*. In particular, petitioner's second proposed question for certiorari merely seeks an advisory opinion about the future effect of the *TrafFix* decision without demonstrating either that the present case turns on the answer to the question posed or that future cases are likely to turn on such an issue.

Petitioner's argument treats any contraction of the scope of trade dress protection as *ipso facto* contrary to public policy, *see, e.g.*, Pet. 20 n.12, through disregarding the considerations that caused this Court in *TrafFix* to "caution against misuse or over-extension of trade dress" in that "product design almost invariably serves purposes other than source identification." 532 U.S. at 29 (quoting *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 213 (2000)). Petitioner's recitation of facts emphasizes the alleged secondary meaning of its syringes, asserted to have been "backed by extensive advertising and promotion that focused on their appearance," as well as the three years said to have been invested in the "design and development" of its syringes. Pet. 5-7. Such considerations misconceive the role of trade dress. As this Court indicated in *TrafFix*, in a passage echoed by the Fifth Circuit:

> Trade dress protection must subsist with the recognition that in many instances there is no prohibition against copying goods and products. In general, unless an intellectual property right such as a patent or copyright protects an item, it will be subject to copying.

Id.; *see* 289 F.3d at 355 (Pet. App. 5a). This Court further explained that considerations like those emphasized by petitioner cannot form the basis of trade dress protection:

> The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity. The Lanham Act, furthermore, does not protect trade dress in a functional design simply because an investment has been made to encourage the public to associate a particular functional feature with a single manufacturer or seller.

532 U.S. at 34-35.

Petitioner also does not mention that there are alternative means to advance the interests served by trade dress protection. Traditional trademarks generally are more effective than product shapes in identifying the source of products to consumers, particularly given the ordinary assumption of consumers that a product shape has a purpose other than source-signification. *See Wal-Mart*, 529 U.S. at 213. In addition, design patent or copyright protection may be sought. *Id.*, at 214. Moreover, when too broadly defined, trade dress becomes an opportunity for a large, well-financed competitor to strong arm its competition. *See Wal-Mart*, 529 U.S. at 213-24.

Eppendorf fails to demonstrate that this Court needs to revisit trade dress issues for the third time in three years in order to expound on the parameters of functionality set forth in *TrafFix*. That decision did much to clarify the law of functionality, as did Congress's 1998 decision to place the explicit burden of proof as to that issue on the proponent of trade dress. *See* 15 U.S.C. § 1125(a)(3). There has not yet been adequate opportunity for the implications of the *TrafFix*

and *Wal-Mart* decisions to be absorbed, applied and refined by the lower courts.

Petitioner has not raised issues that suggest this case should serve as a vehicle to again address the functionality doctrine. Eppendorf alleges that the Fifth Circuit did not give adequate attention to its claimed trade dress considered as a whole, Pet. 17-18, 19 n.11, but the Fifth Circuit found that Eppendorf failed to demonstrate the non-functionality of each of the eight trade dress elements it sought to prove at trial. 289 F.3d at 357-58 (Pet. App. 11a) ("all eight design elements identified by Eppendorf are essential to the operation of the Combitips").

A trade dress wholly made up of functional elements could be eligible for trade dress protection only in the unlikely event that there was something arbitrary and non-functional about the arrangement of those elements. There was no evidence of that in this case. The flange on Eppendorf's syringes was located where it was located because it had to fit into the dispenser at that location. Likewise, the fins under the flange had to be under the flange in order to give the flange support. The same is true for the other elements.

If there were any merit to Eppendorf's argument that the whole of its trade dress is greater than the sum of its elements, the Fifth Circuit could have ruled for Eppendorf based on existing law. *See, e.g., Sunbeam Prods., Inc. v. Westbend Co.*, 123 F.3d 246, 256-57 (5th Cir. 1997). Nothing in *TrafFix* suggests that such issues cannot be considered by courts and nothing in the Fifth Circuit's decision suggests that it so construed *TrafFix*. Instead, Eppendorf's product was a plastic syringe of uncomplicated, geometric design that simply did not lend itself to trade dress protection, considered element by element or as a whole.

There is no need for this Court to clarify the law as to such issues or to revisit that essentially factual question.

CONCLUSION

The petition for a writ of certiorari should be denied.

November 6, 2002

Respectfully submitted,

WILLIAM J. UTERMOHLEN
OLIFF & BERRIDGE, PLC
277 South Washington Street
Suite 500
Alexandria, VA 22314
(703) 836-6400

Counsel for Respondents

Supreme Court, U.S.
FILED
NOV 19 2002
OFFICE OF THE CLERK

No. 02-300

IN THE

Supreme Court of the United States

EPPENDORF-NETHELER-HINZ GMBH,

Petitioner,

v.

RITTER GMBH AND
RK MANUFACTURING, INC.,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

REPLY BRIEF OF PETITIONER

CARTER G. PHILLIPS
JOSEPH V. JEST
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

PETER J. TOREN*
DAVID TOREN
SIDLEY AUSTIN BROWN & WOOD LLP
787 Seventh Avenue
New York, NY 10019
(212) 839-5300

Counsel for Petitioner

November 19, 2002

* Counsel of Record

WILSON-EPES PRINTING CO., INC. – (202) 789-0096 – WASHINGTON, D. C. 20001

13 pp

TABLE OF CONTENTS

	Page
INTRODUCTION	1
ARGUMENT	2
CONCLUSION	10

TABLE OF AUTHORITIES

CASES — Page

Clicks Billiards, Inc. v. *Sixshooters, Inc.*, 251 F.3d 1252 (9th Cir. 2001) 5

In re Morton-Norwich Prods., Inc., 671 F.2d 1332 (C.C.P.A. 1982) 5

Newborn Bros. & Co. v. *Dripless, Inc.*, Opposition No. 113,471, 2002 WL 1899729 (T.T.A.B. Aug. 16, 2002) 3

TrafFix Devices, Inc. v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001) 1, 8

Valu Eng'g, Inc. v. *Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002) 1, 4, 5

Wal-Mart Stores, Inc. v. *Samara Bros., Inc.*, 529 U.S. 205 (2000) 5, 7

STATUTES AND REGULATIONS

15 U.S.C. §§ 1062-1064 3

37 C.F.R. §§ 2.101-2.146 3

SCHOLARLY AUTHORITY

1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* (4th ed. 2002) 7

REPLY BRIEF OF PETITIONER

INTRODUCTION

Aware of the infirmities of the decision below, respondents seek to re-direct the Court's attention away from the Fifth Circuit's ruling and the questions presented by the petition. Respondents engage in pages of selective and misleading—and, above all, wholly irrelevant—discussion aimed, apparently, at suggesting to the Court that the jury, district court, and the court of appeals should have ruled in their favor on the basis of laches. See Opposition ("Opp.") 1-3. None of them did so, of course, and nothing relating to any purported laches issue or litigation has any bearing on the instant petition.

Respondents finally acknowledge beginning on page 4 of their opposition that the questions presented here relate to the "non-functionality" or "functionality" of the Combitips trade dress owned by petitioner, but then shift direction, this time launching into a lengthy selection of assorted factual assertions that bear little resemblance to the findings or the record of the two-week trial in this case. See Opp. 4-7. For example, although embracing the Fifth Circuit's ruling when it suits their purposes, respondents nonetheless contend that there was insufficient evidence of available alternative designs, see *id.* at 4-5, a contention soundly rejected by the Fifth Circuit. App. 9a ("Indeed, there is extensive testimony in the record regarding available alternative designs for each of the eight elements."); Petition ("Pet.") 7-8, 10.

These efforts at misdirection and misstatement cannot salvage respondents' strained efforts to deny the existence of a circuit conflict. See Opp. 8-10. The Fifth Circuit decision below plainly conflicts with the Federal Circuit's decision in *Valu Eng'g, Inc.* v. *Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002), as to whether, in light of this Court's decision in

TrafFix Devices, Inc. v. *Marketing Displays, Inc.*, 532 U.S. 23 (2001), evidence of the availability of alternative designs remains relevant in determining whether product trade dress is legally "non-functional" or "functional." Nor can they paper over the misreading of *TrafFix* that resulted in the Fifth Circuit's erroneous conclusion that *TrafFix* changed the traditional test for determining "non-functionality" or "functionality" so as to limit Lanham Act protection to trade dress that is composed only of "ornamental" or "arbitrary" or "incidental" features. The Fifth Circuit's fundamentally flawed reading of *TrafFix* effectively creates a new, threshold test that ignores the crucial and long-recognized distinction between *de facto* functionality and *de jure* functionality, and thus calls into question the continued viability of protection under the Lanham Act for "non-functional" product trade dress.

ARGUMENT

1. Respondents contend that no circuit conflict exists based upon the contention that in *Valu Engineering* the Federal Circuit affirmed a ruling that the product design at issue there was legally "functional" on the facts of that case. Opp. 9. This cannot be regarded as a serious argument against certiorari. It cannot be gainsaid that circuit conflicts exist based upon conflicts regarding matters of law or legal interpretation, whether of statutory or constitutional provisions or decisions of this Court. In *Valu Engineering*, the Federal Circuit analyzed this Court's decision in *TrafFix* at length, including the patent-related and product-specific evidence that was determinative there, in holding that evidence of the availability of alternative designs remains relevant after *TrafFix*. This legal standard is binding in trade dress registration matters pending before the United States Patent & Trademark Office ("PTO"), and thus has a nationwide impact upon product trade dress rights in this country. Without considering these aspects of *TrafFix*, the

Fifth Circuit came to the opposite conclusion and applied a contrary legal standard. In short, the Federal Circuit concluded that *TrafFix* did not change the traditional test for determining "non-functionality" or "functionality"—a conclusion consistent with this Court's re-affirmation of the *Inwood* standard in *TrafFix*—while the Fifth Circuit held that *TrafFix* superseded its well-developed "functionality" jurisprudence, and did so even though this Court had previously cited that jurisprudence with approval. Pet. 20 & n.12.

This conflict simply does not disappear because on the facts of *Valu Engineering*, the Federal Circuit did not find that the product trade dress there was "non-functional." Indeed, the PTO's Trademark Trial and Appeal Board ("TTAB") recently has applied the holding of *Valu Engineering* that alternative design evidence remains relevant after *TrafFix* on at least one occasion in finding a product design trade dress to be "non-functional," rejecting contentions of both "utilitarian" and "aesthetic" functionality. *Newborn Bros. & Co.* v. *Dripless, Inc.*, Opposition No. 113,471, 2002 WL 1899729, at *7-*12 (T.T.A.B. Aug. 16, 2002) (not citable as precedent before the TTAB) (involving the color yellow as applied to a caulking gun). Thus, a conflict plainly exists, involves an issue of recognized importance to our national economy, Pet. 11-12, 20-22, and will arise on a recurring basis. The PTO will continue to consider product trade dress registration applications and related proceedings,[1] and when faced with infringing users, trade dress owners will continue to be compelled to file suit, including in district courts within the

---

[1] The TTAB hears proceedings instituted by interested parties seeking the cancellation of existing registrations, oppositions filed against applications that have been approved by a PTO trademark examiner as meeting the criteria for registration and "published for opposition" prior to issuance of a registration, as well as appeals by applicants of registration refusals issued by PTO trademark examiners. *See* 15 U.S.C. §§ 1062-1064; 37 C.F.R. §§ 2.101-2.146. *Valu Engineering* involved an appeal to the Federal Circuit of a TTAB opposition proceeding ruling.

Fifth Circuit, to protect and enforce trade dress registrations granted by the PTO or their common law trade dress rights.

Moreover, to the extent arguably pertinent here, the facts of *Valu Engineering*—or, more precisely, the types of functionality evidence presented there—are instructive given their similarity to *TrafFix* and the stark contrast they pose with the facts in this case. *Valu Engineering* involved a trade dress that had been the subject of a utility patent application that disclosed certain utilitarian advantages of the claimed design, the registration applicant's advertising focused on the utilitarian advantages of the product (rather than the look or appearance of the product),[2] alternative designs were limited at best, and the claimed design resulted in a comparatively simple or cheap method of manufacturing.[3] *Valu Eng'g*, 278

---

[2] Respondents claim that the petition inaccurately states that the marketing and promotion of the Combitips focused on the look or appearance of the Combitips design. Opp. 4, 6. The record is uncontradicted, however, in this regard. *See* Pet. 7 (citing record). For example, Robert Diller, who was closely involved with the marketing and promotion of the Combitips during nearly the entire period of time from the introduction of that design into the U.S. market to the time of trial, testified that:

> We wanted to be sure that we caught the design, shape and the silhouette of the instrument because, again, it was very unique. The marketplace had not seen anything like this before. And as I said earlier, the advertising [was designed] to be repetitive . . . .

T.299/1-6; *see also* T.256/2-6 ("We put together a marketing plan, an advertisement plan on how to promote the product, how to get the maximum exposure of the product, exposure of the look of the product and design of the product . . . [and did] that in several ways."); T.270/1-13 (the "unique" and "very identifiable" look of the Combitips "absolutely" was important in marketing and selling the product).

[3] Respondents assert that each element of the Combitips trade dress "was the simplest design available," but cite no evidence to support this assertion. Opp. 4. Nor did petitioner admit that "[s]implicity is functional," as Respondents assert at Opp. 4-5. The selectively quoted testimony that purportedly supports this assertion is immediately followed in the record by testimony that "there are many ways of making a simple design." T.394/12-13; *see also* T.394/21-395/3 (there are alternative

F.3d at 1272. Thus, all of the *Morton-Norwich* factors[4] weighed in favor of a finding of "functionality," *id.*, and, not surprisingly, the *Valu Engineering* court found substantial evidence existed supporting that finding. *Id.* at 1279.

Respondents also argue that the Fifth Circuit's failure to "even mention" *Valu Engineering* in its opinion means that the Fifth Circuit "presumably recognize[ed] that nothing in the Federal Circuit's decision was relevant to resolution of the present case." See Opp. 9-10. Rather than demonstrating the absence of a conflict, however, the failure to cite or discuss *Valu Engineering* further points to the Fifth Circuit's failure to analyze *TrafFix* properly or in depth. In addition to not mentioning *Valu Engineering*, the Fifth Circuit also failed to discuss the question presented in *TrafFix* or the patent-related and product-specific evidence that was determinative there. Similarly, the Fifth Circuit also was aware, for example, that no utility patent evidence existed in this case, that the advertising and promotion of the Combitips focused on the look or appearance of the Combitips design, and that there

---

designs that "would be different and still simple"). Indeed, the record in this regard cannot credibly be disputed, *see id.*; Pet. 6-10; App. 27a-30a; App. 31a, as is at least implicit in the Fifth Circuit's finding that extensive alternative designs exist for each of the elements of the Combitips trade dress. *See* App. 8a-9a. Moreover, those courts of appeals that consider "simplicity" of design as a factor in product trade dress cases do not examine whether the design is "simple," but whether it is "comparatively simple" as to the available alternative designs. *See, e.g., Valu Eng'g*, 278 F.3d at 1274 (citing *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1340-41 (C.C.P.A. 1982)); *Clicks Billiards, Inc.* v. *Sixshooters, Inc.* 251 F.3d 1252, 1260 (9th Cir. 2001) (citing cases). Respondents' argument also confuses the concept of "inherent distinctiveness" with "functionality." *See Morton-Norwich*, 671 F.2d at 1343 (TTAB improperly intermixed lack of inherent distinctiveness with functionality and erred in finding that design of spray gun was functional because it was ordinary looking). The concept of "inherent distinctiveness" is, furthermore, no longer applicable in the context of product design trade dress after *Wal-Mart Stores, Inc.* v. *Samara Brothers, Inc.*, 529 U.S. 205 (2000).

[4] *See Morton-Norwich*, 671 F.2d at 1340-41; Pet. 14 n.7.

was extensive evidence of available alternative designs. Of these, the Fifth Circuit only discussed the extensive evidence of alternative designs, Pet. 9-10, and then compounded its legal error by dismissing that evidence as irrelevant, holding based upon its misreading of *TrafFix*, that "alternative designs are not germane to the traditional test for functionality." App. 11a.; Pet. 10.

2. Respondents also contend that petitioner seeks a "rehearing of the *TrafFix* case" and to limit *TrafFix* "solely to the context of alleged trade dress features formerly covered by a utility patent." Opp. 10. This argument misstates petitioner's position and ignores *TrafFix*'s re-affirmation of the traditional *Inwood* test.

As plainly stated in the petition, under the traditional *Inwood* test the Combitips trade dress is "non-functional." This test applies whether or not the trade dress in question is claimed as part of a utility patent or application. In accord with this test, petitioner proved at trial that the Combitips design trade dress could be changed without affecting use or purpose or (adversely) affecting cost or quality. Pet. 6-9. Indeed, petitioner not only made this showing as to the overall Combitips design, but as to each of the individual elements of that design, and also showed that it had developed a design with a different trade dress that lowered costs and improved functionality. *Id.* at 6-7. .

As discussed above, the Fifth Circuit failed to address crucial evidence on the issue of "non-functionality" in this case. The Fifth Circuit did acknowledge the availability of extensive alternative designs and that design features could be changed in appearance without affecting function. See App. 9a-10a. But, based upon a fundamental misreading of *TrafFix* that respondents seek to perpetuate, the Fifth Circuit reversed, effectively equating *de facto* function with *de jure* functionality and holding that, after *TrafFix*, only "ornamental," "arbitrary" or "incidental" product features are protectable as trade dress.

This Court did not so hold in *TrafFix*. As discussed in the petition (at 19-20), had it intended to do so, the Court quite simply could have noted, as was undisputed in *TrafFix*, that the springs in the dual-spring design at issue there were *de facto* functional and held, without more, that the design was *de jure* "functional."

Respondents do not answer this argument. See Opp. 10-12. This is because the "functionality" doctrine announced by the Fifth Circuit below is unsustainable given that all products are *de facto* functional and almost always contain features that serve a *de facto* function or purpose. Pet. 17-18. Indeed, even ignoring the consistent rule that "non-functionality" or "functionality" is to be determined based upon the trade dress as a whole, rather than selectively focusing on individual elements of the design, arguably all design elements can affect or contribute to the use or cost of a product, even if merely or purely ornamental. *Id.*

Furthermore, although respondents seek improperly to dispute the findings of the jury and the district court as to "secondary meaning," see Opp. 6, they ignore what actually is the relevant aspect of secondary meaning with regard to the "functionality" doctrine and the instant petition. Under *Wal-Mart Stores, Inc.* v. *Samara Brothers, Inc.*, 529 U.S. 205, 216 (2000), design trade dress can only serve as a trademark and thus be eligible for protection upon a showing of secondary meaning. It is, however, well-established that if a design is merely or primarily ornamental, it cannot serve a source-identifying function and thus cannot be a trademark.[5] Thus, if the new, threshold "ornamental, arbitrary or incidental" test set out by the Fifth Circuit is allowed to stand, trade dress owners would face a classic "Catch-22." The very evidence

---

[5] *See* 1 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 7:24 (4th ed. 2002) ("A symbol or design that is only incidentally ornamental and decorative, can still be a trademark. But if a design is solely or merely ornamental, it cannot be a trademark.") (footnotes omitted) (citing numerous cases).

of "ornamentality" that a design trade dress plaintiff would be required to produce in order to prove "non-functionality" could be used to undermine any attempted showing of secondary meaning, thus negating any assertion of trade dress rights in that design.

In short, the new "functionality" test formulated by the Fifth Circuit conflicts with this Court's jurisprudence. This Court did not consider or announce a rule, either in Part III of its *TrafFix* opinion, as respondents suggest (Opp. 10-11), or elsewhere in that opinion, that only "ornamental" or "arbitrary" or "incidental" designs or product features could qualify as prosecutable trade dress. Rather, it emphatically re-affirmed the traditional *Inwood* test. 532 U.S. at 32-33.

3. Respondents assert that no further guidance is needed from this Court at this time either as to the issues of law raised by petitioner or based upon the facts of this case. See Opp. 7, 13-16. But the conflict generated by the Federal Circuit and Fifth Circuit decisions belies this notion as to the questions presented here. Those questions concern the protection of trade dress rights under the Lanham Act, a matter of recognized importance to our national economy, Pet. 4-5, 20-22, protection that is threatened and perhaps effectively eliminated by the decision below. *Id.* Respondents' characterize this concern as based upon a "myopic view of the role of product design trade dress," Opp. 13, but that concern is squarely grounded in important Congressional goals and the pro-competitive and pro-consumer benefits that protection is designed to achieve. Pet. 4-5, 12, 20-22. Moreover, respondents have failed to identify any benefit to our economy from the type of conduct in which they engaged in this case. *Id.* at 22.

Respondents' assertion that petitioner "merely seeks an advisory opinion about the future effect of the *TrafFix* decision" is similarly unavailing. Opp. 13. Respondents fail to explain why, absent repeal of pertinent provisions of the Lanham Act, "future cases are [not] likely to turn" (see *id.*) on

whether the lower federal courts properly apply the *Inwood* test in light of *TrafFix* or whether they will continue to distinguish between *de facto* function—which all products and arguably all product features possess—and *de jure* functionality.

Nor do respondents substantiate their curious assertion that the questions presented are not dispositive in this case. Opp. 7, 13. The Fifth Circuit overturned a unanimous jury verdict reached after a two-week trial and reversed the district court's judgment without remand solely on the issue of "functionality." That decision was based upon the Fifth Circuit's conclusion that *TrafFix* changed the law of "functionality," explicitly concluding in the process that the jury had been properly charged under its pre-*TrafFix* case law. App. 7a-8a.

Respondents also fail to explain why, if the "functionality" of the Combitips design was so conclusively evident that it rendered immaterial all evidence of available alternative designs (or other evidence of "non-functionality"), see Opp. 15, they nonetheless insist on disputing the very availability of such alternatives and seek to prop up the Fifth Circuit's decision on grounds other than "functionality."[6] Indeed, rather than supporting their position, respondents' efforts to re-write the record and to re-direct the Court's attention away from the legal issues presented here to immaterial and unsubstantiated factual assertions merely highlight the flaws in their argument and the clear need for review by this Court.

---

[6] Respondents also fail to explain why, if they believed copying the Combitips design was lawful, they strove so mightily at trial to deny having copied it. *See* App. 18a-22a. Respondents even go so far to dispute in their opposition that they denied having copied the Combitips design at trial. *See* Opp. 7. The district court found, however, that they had denied copying the Combitips design, and also found that testimony to be incredible, specifically identifying evidence that respondents had doctored a photograph in an effort to cover up their intentional copying. *See* App. 19a-20a.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

CARTER G. PHILLIPS
JOSEPH V. JEST
SIDLEY AUSTIN BROWN & WOOD LLP
1501 K Street, N.W.
Washington, D.C. 20005
(202) 736-8000

PETER J. TOREN*
DAVID TOREN
SIDLEY AUSTIN BROWN & WOOD LLP
787 Seventh Avenue
New York, NY 10019
(212) 839-5300

Counsel for Petitioner

November 19, 2002

* Counsel of Record